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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1988

RICHARD ANDERSON PHOTOGRAPHY,

Petitioner,

– v.–

RADFORD UNIVERSITY, *et al.*,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

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QUESTION PRESENTED

Does the Eleventh Amendment deny to copyright owners the exclusive federal court damage remedy provided by Congress in the Copyright Act of 1976 (17 U.S.C. § 101–810) whenever the infringer is a state or state agency?

LIST OF PARTIES

The parties to the proceedings below were petitioner Richard Anderson Photography, Inc., and respondents Radford University, Deborah Brown, the Visitors of Radford University, Bernice Thieblot and Armand Thieblot.

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

Petitioner Richard Anderson Photography ("Anderson") respectfully requests that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Fourth Circuit entered on July 20, 1988.

OPINIONS BELOW

The opinion of the United States Court of Appeals for the Fourth Circuit, affirming the dismissal of Anderson's damage action for copyright infringement against Radford University, an instrumentality of the Commonwealth of Virginia, is officially reported at 852 F.2d 114 and is reprinted at pages 1a-84a of the Appendix to this petition. The opinion of the United States District Court for the Western District of Virginia dismissing Anderson's damage action is reported at 633 F. Supp. 1154 and is reprinted at pages 85a-115a of the Appendix to this petition.

JURISDICTION

The judgment of the United States Court of Appeals for the Fourth Circuit was entered on July 20, 1988. Jurisdiction of this Court is invoked pursuant to 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

This case involves article I, section 8, clause 8 (the "Copyright and Patent Clause") and the Eleventh Amendment of the Constitution of the United States.

It also involves sections 501(a) and (b) and 504(a) of the Copyright Act of 1976 (17 U.S.C. §§ 501(a) and (b), 504(a)), granting copyright owners a damage remedy against "anyone" who infringes a copyright, and 28 U.S.C. § 1338(a), which provides that the federal district courts shall have exclusive jurisdiction in copyright cases. Finally, it involves sections 602(a)(1), 110(2), 110(6), 110(8), 111(a)(2), 112(d) and 118(d)(3) of the Copyright Act of 1976 (17 U.S.C. §§ 602(a)(1), 110(2), (6) and (8), 111(a)(2), 112(d) and 118(d)(3)), which exhibit Congress' intent to subject the States to suit for copyright infringement.

The texts of these provisions are set out on pages 116a - 148a of the Appendix.

STATEMENT OF THE CASE

The Eleventh Amendment to the Constitution has commanded this Court's attention several times in recent years,[1/] but never once has this Court been faced with the problem presented in this case, where recognition of a state's Eleventh Amendment immunity totally forecloses a damage remedy created by Congress. For each

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[1/] *See, e.g., Welch* v. *State Dep't of Highways and Public Transp.*, 107 S. Ct., 2941 (1987); *Atascadero State Hosp.* v. *Scanlon*, 473 U.S. 234 (1985); *County of Oneida* v. *Oneida Indian Nation*, 470 U.S. 276 (1985); *Pennhurst State School and Hosp.* v. *Halderman*, 465 U.S. 89 (1984); *Fitzpatrick* v. *Bitzer*, 427 U.S. 445 (1976); *Edelman* v. *Jordan*, 415 U.S. 651 (1974); *Employees* v. *Missouri Dep't of Pub. Health and Welfare*, 411 U.S. 279 (1973).

time this Court has previously upheld an Eleventh Amendment bar, the issue was "not the general immunity of the States from suit . . . but merely the susceptibility of the States to suit before *federal tribunals*." *Atascadero State Hospital* v. *Scanlon*, 473 U.S. 234, 240 n.2 (1985) (emphasis in original). In copyright cases, however, because the jurisdiction of the federal courts is *exclusive* under 28 U.S.C. § 1338(a), the effect of an Eleventh Amendment defense is not simply to relegate the injured party to a suit in state court, but to deny any damage recovery at all against state infringers.

The facts of this case are typical of the burgeoning number of cases around the country in which states and state agencies have sought, and increasingly won, dismissal on Eleventh Amendment grounds of damage suits for many varied kinds of copyright infringement. 2/

In 1981, Radford University, an educational instrumentality of the Commonwealth of Virginia ("Radford"), contracted with the North Charles Street Design Organization ("NCSDO") of Baltimore, Maryland, to produce a student prospectus. NCSDO in turn contracted with Anderson to provide the photographs for use in Radford's 1982 student prospectus. Anderson took and obtained copyrights for a large set of photographs, some of which ultimately were published in

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2/ Eleventh Amendment immunity was rejected in *Mills Music Inc.* v. *Arizona*, 591 F.2d 1278 (9th Cir. 1979) (performance of copyrighted music at Arizona State Fair) and *Johnson* v. *University of Virginia*, 606 F. Supp. 321 (W.D. Va. 1985) (use of copyrighted photographs of University sporting events). It was upheld in the instant case and in *B.V. Engineering* v. *University of California, Los Angeles*, No. 87-5920 (9th Cir. Oct. 3, 1988) (copying of copyrighted computer program and user manual); *Mihalek Corp.* v. *Michigan*, 595 F. Supp. 903 (E.D. Mich. 1984), *aff'd on other grounds*, 814 F.2d 290 (6th Cir.), *cert. denied*, 108 S. Ct. 503 (1987) (use of copyrighted material in state tourism campaign); *Woelffer* v. *Happy States of America, Inc.*, 626 F. Supp. 499 (N.D. Ill. 1985) (same); *Cardinal Industries, Inc.* v. *Anderson Parrish Assocs. Inc.*, No. 83-1038-Civ.-T-13 (M.D. Fla. Sept. 6, 1985) (unreported), *aff'd*, No. 86-3554 (11th Cir. 1987) (unauthorized use of copyrighted architectural drawings in dormitory construction); and *Lane* v. *First Nat'l Bank of Boston*, No. 85-0520-H (D. Mass. May 19, 1988), *appeal pending*, No. 88-1815 (1st Cir. 1988) (use of copyrighted computer program).

the 1982 prospectus produced by NCSDO, as authorized by Anderson's contract. However, sometime later, Anderson learned that Radford, through Deborah Brown, its Director of Public Information and Relations, was using his copyrighted photographs without authorization in other University publications, in violation of Anderson's exclusive rights under the Copyright Act of 1976, 17 U.S.C. §§ 106(1)–(3), (5). Accordingly, Anderson brought this action in the United States District Court for the Western District of Virginia, pursuant to 17 U.S.C. § 504(a) and 28 U.S.C. § 1338(a), against Radford, its governing board, and Brown, alleging copyright infringement and seeking injunctive and monetary relief.

When Radford returned the photographs, Anderson dropped the claim for injunctive relief but continued to pursue the claim for damages against all the named defendants. On April 23, 1986, the District Court granted the defendants' motion to dismiss as to Radford, its Board and Brown (insofar as she was sued in her official capacity), on the sole ground that states are absolutely immune under the Eleventh Amendment from damage suits for copyright infringement.[3/] The District Court held (633 F. Supp. 1154, 1158; App. at 97a–98a) that Congress did not have the power to abrogate Eleventh Amendment immunity under the Copyright and Patent Clause of Article I of the Constitution, and thus did not reach the question of whether, assuming that power exists, Congress effectively exercised it in enacting the Copyright Act of 1976.[4/] The District Court also

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[3/] The District Court also held that suit against Brown in her individual capacity was not barred by the Eleventh Amendment, but nevertheless dismissed that claim under an immunity provided by Virginia law to state officials in performance of discretionary functions. The Court of Appeals unanimously reversed the dismissal against Brown in her individual capacity on state law grounds and remanded for further proceedings. 852 F.2d at 122; App. at 44a–45a. That claim is not involved in this Petition.

[4/] The issue of Congress' power to abrogate Eleventh Amendment immunity in Article I legislation is currently before this Court for decision in *Pennsylvania* v. *Union Gas Co.*, 832 F.2d 1343 (3d Cir. 1987), *cert. granted*, 108 S. Ct. 1219 (1988), in which oral argument has been set for October 31, 1988.

rejected Anderson's alternative claim that the Commonwealth had constructively consented to suit, waiving its Eleventh Amendment immunity by participating, through use of copyrighted materials, in conduct exclusively regulated by Congress (633 F. Supp. at 1159; App. at 106a).

In a 2–1 decision handed down on July 20, 1988, the Fourth Circuit affirmed the District Court's dismissal on Eleventh Amendment grounds. Leaving to one side the threshold issue of Congress' power to abrogate under the Copyright and Patent Clause, the majority held that this Court's abrogation test, as enunciated in *Atascadero*, *supra*, 473 U.S. at 242, and *Welch*, *supra*, 107 S. Ct. at 2944–45, that "Congress may abrogate the States' constitutionally secured immunity from suit in federal court only by making its intention unmistakably clear in the language of the statute," was not met by the Copyright Act of 1976. The majority also rejected Anderson's alternative theory, that the Commonwealth of Virginia had constructively consented to waive Eleventh Amendment immunity. (852 F.2d at 117, 120–22; App. at 16a, 33a–39a).

In a lengthy dissent (which will be discussed in more detail below), Judge Boyle took issue with the majority's refusal to find clear and unequivocal evidence of congressional intent to abrogate in the language of the Copyright Act.[5/] Considering § 501 of the Act (17 U.S.C. § 501), authorizing suit against "anyone who infringes a copyright," together with several express exemptions from liability for "governmental bodies" (and, in § 602, for "any State or political subdivision of a State"), Judge Boyle concluded that the Copyright Act did indeed meet the *Atascadero* test.

5/ Preliminarily, Judge Boyle addressed the issue of Congress' power to abrogate when legislating under Article I of the Constitution, and concluded that it did have such power. (852 F.2d at 123–25; App. at 49a–61a).

REASONS FOR GRANTING WRIT

I.

THE FOURTH CIRCUIT'S DECISION FRUSTRATES THE WIDESPREAD EXPECTATION OF COPYRIGHT OWNERS BASED ON EARLIER PRECEDENT AND UNDERMINES THE UNIFORM NATIONAL SYSTEM OF COPYRIGHTS

This Court should grant certiorari to review the Fourth Circuit's decision, because it

- constitutes the first instance in which the Eleventh Amendment has been applied to deny entirely a damage remedy enacted by Congress;

- misconceives and misapplies this Court's rulings in *Atascadero* and *Welch*;

- contradicts earlier judicial decisions, the conclusion of the Register of Copyrights and even the assumptions of most states; and

- decides an important constitutional question in a way which undermines the uniform national system of copyrights, frustrates the widespread expectations of copyright owners and severely diminishes the value of all copyrights.

Although the decision below denies the copyright damage remedy to one photographer for one university's unauthorized use of his photographs, that decision and similar recent decisions elsewhere [6/] are of great significance to all whose stock in trade is

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[6/] *See* note 2 *supra*.

intellectual property — copyrights and patents.[7/] Because federal court jurisdiction in this area is *exclusive* under 28 U.S.C. § 1338(a), recognition of an Eleventh Amendment defense closes the doors not only of the federal courts, but of all courts, to copyright damage suits against infringing states. That in turn "will allow states to violate the federal copyright laws with virtual impunity." *BV Engineering* v. *University of California, Los Angeles*, No. 87-5920 (Oct. 3, 1988), Slip. Op. at 12427.[8/] The decision below thus significantly diminishes the value of all copyrights (and patents as well), by denying their owners, in all cases of state infringement, the most effective weapon in the "potent arsenal of remedies against an infringer." *Sony Corp. of America* v. *Universal City Studios, Inc.*, 464 U.S. 417, 433 (1984).

The potential injury cannot be understated. As described in a recent Report to Congress on this very issue by the Register of Copyrights, the fifty states and their hundreds of agencies and instrumentalities are increasingly significant users of intellectual property. Register of Copyrights, *Copyright Liability of States and the Eleventh Amendment* (June 1988) (hereinafter *Copyright Office Report*), at 5-17. All of the states and their agencies utilize, exhibit, perform and copy these protected works thousands of times every day. The issue presented is thus important not only for copyright and patent proprietors,

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[7/] The importance of this issue is shown by the fact that *amicus curiae* briefs were filed in the Fourth Circuit by: National Music Publishers' Association, Inc.; American Society of Composers, Authors and Publishers; Broadcast Music, Inc.; Music Publishers' Association of the United States, Inc.; The Songwriters Guild of America; Volunteer Lawyers for the Arts, Inc.; Barbara Ringer; John M. Kernochan; William F. Patry; the Association of American Publishers; the Association of American University Presses, Inc.; the Information Industry Association; and the American Intellectual Property Law Association.

[8/] The Ninth Circuit's opinion earlier this month in *BV Engineering* concurred with, and on most points merely cited and followed, the Fourth Circuit's decision here. However, as the quoted sentence shows, the Ninth Circuit expressly recognized the devastating impact of its ruling, but concluded "[i]t is for Congress . . . to remedy this problem." Slip Op. at 12427. By granting this petition, this Court can consider, and decide definitely, whether that is so.

but for all of the fifty states. (*Cf. McGee* v. *International Life Ins. Co.*, 355 U.S. 220, 221 (1957)).

The use of copyrighted photographs in state college catalogs and other state agency publications, as in the instant case, is only one example. Others abound: copyrighted music is repeatedly performed, sung and danced to in school and college concert halls and football stadiums, on college and public radio stations and at fraternity social functions; copyrighted motion pictures are exhibited on state college campuses and in state prisons; the latest scientific technology, electronic know-how and computer programs are utilized by state instrumentalities in great profusion. And yet, the decision below would allow these governmental bodies to utilize the creative and scientific works of others — from popular songs to modern symphonies, from the latest movies to lengthy literary manuscripts, from computer software to patented machinery — without paying royalties and without the fear of a damage suit which motivates every other user to obey the law. Indeed, the Register of Copyrights concluded in his recent Report that "copyright proprietors have demonstrated they will suffer immediate harm if they are unable to sue infringing states in federal court." *Copyright Office Report* at 103.

It is no wonder that, until fairly recently, it had been the widespread expectation of individual copyright owners, based on sound judicial authority, that states are amenable to suits for copyright infringement. After an exhaustive review of the law surrounding this issue, the Register of Copyrights was "convinced that Congress intended to hold the states responsible under the federal copyright law." *Copyright Office Report* at 103. Indeed, as one court noted in the analogous patent sphere, "it would . . . surprise our citizens to learn that their exclusive right to a patent was not exclusive and that governmental units could infringe upon that right." *Lemelson* v. *Ampex Corp.*, 372 F. Supp. 708, 712 (N.D. Ill. 1974).

In practice, the states have long accepted their liability and amenability to suit under the copyright laws. At least eleven state Attorneys General have advised state agencies that they *are* subject to the

copyright laws.[9]/ And state governments have for years been paying royalties for their use of copyrighted materials. The decision below threatens to undermine this well-established system of collecting copyright royalties for widespread state use of copyrighted works.

It also threatens to undermine the uniform national system of copyright and patent protection entrusted to Congress under Article I of the Constitution.[10]/ As this Court recognized in *Goldstein* v. *California*, 412 U.S. 546 (1973), "the objective of the Copyright Clause was clearly to facilitate the granting of rights *national in scope*," 412 U.S. at 555 (emphasis added); *see also Harper & Row* v. *Nation Enterprises*, 471 U.S. 539 (1985); *Sears, Roebuck & Co.* v. *Stiffel Co.*, 376 U.S. 225 (1964). When they ratified the Copyright and Patent Clause, the states ceded to the federal government their sovereign power over copyrights. As this Court has said, "[t]he States cannot exercise a sovereign power which, under the Constitution, they have relinquished to the Federal Government for its exclusive exercise." *Goldstein*, *supra*, 412 U.S. at 552.

Congress' grant to the federal courts of exclusive jurisdiction over copyright cases in 28 U.S.C. § 1338(a) was a cornerstone of this uniform system of rights and remedies. The objective was to keep state courts entirely out of the lawmaking process in this critical sphere, in order to insure the uniformity the framers intended. *See, e.g.*, *Sears*, *supra*, 376 U.S. at 231. Thus, the system of rights and remedies established by Congress pursuant to the Copyright and Patent

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[9]/ 107 Op. Att'y Gen. Alaska (1983); 366 Inf. Op. Att'y Gen. Alaska 404 (1982); 187 Slip Op. Att'y Gen. Ariz. 16 (1986); 71 Op. Att'y Gen. Cal. 16 (1988); 65 Op. Att'y Gen. Cal. 106 (1982); 64 Op. Att'y Gen. Cal. 186 (1981); 82 Op. Att'y Gen. Fla. 148 (1982); 81 Slip Op. Att'y Gen. Kan. 202 (1981); 84 Slip Op. Att'y Gen. La. 436 (1985); 82 Slip Op. Att'y Gen. La. 662 (1982); 1987 Copyright L. Rep. (CCH) ¶ 26,240 (Ohio Attorney General); 14 Op. Att'y Gen Okla., 317 (1982) Slip Op. Att'y Gen. S.C. (1977); Slip Op. Att'y Gen. Tex. No H1260 (1978); 82 Slip. Op. Att'y Gen. Utah 03 (1982).

[10]/ Art. I., § 8, cl. 8 gives Congress the exclusive power "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . . ."

Clause is so "pervasive [that] no citizen or State may escape its reach." *Goldstein, supra*, 412 U.S. at 560 (emphasis added). But the effect of the decision below is precisely to undermine the pervasiveness of the federal copyright system and create a means by which the states may indeed "escape its reach."

Perhaps in recognition of these paramount interests in national uniformity, when federal courts were even confronted with an Eleventh Amendment defense in copyright and patent cases prior to 1984 — and they rarely were — all but one of them rejected it. *Mills Music, Inc.* v. *Arizona*, 591 F.2d 1278 (9th Cir. 1979); *Johnson* v. *University of Virginia*, 606 F. Supp. 321 (W.D. Va. 1985); *Lemelson* v. *Ampex Corp., supra*. *See also Howell* v. *Miller*, 91 F. 129, 137 (6th Cir. 1898) (Harlan, Circuit Justice) (state "officers cannot interpose their official character, or the orders of the state, against such relief as may be granted" under federal copyright laws).[11/]

In *Mills Music*, the Ninth Circuit found it "clear that the abrogation of a state's Eleventh Amendment immunity is inherent in the Copyright and Patent Clause and the Copyright Act." 591 F.2d at 1285. Relying on this Court's previous Eleventh Amendment opinions and on *Goldstein* v. *California, supra*, the Ninth Circuit concluded (*id.* at 1286):

> a state may not, consistent with the Constitution, infringe the federally protected rights of the copyright holder, and thereafter avoid the federal system of statutory protections. The "exclusive Rights" of an author, guaranteed under the Constitution and Copyright Act, would surely be illusory were a state permitted to appropriate with impunity the rights of lawful copyright holder. Accordingly, we conclude that the Eleventh

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[11/] The one exception prior to 1984 was *Wihtol* v. *Crow*, 309 F.2d 777, 782 (8th Cir. 1962), which summarily upheld the Eleventh Amendment defense in a copyright case in one paragraph, with no analysis beyond the observation that the defendant school district was "an instrumentality of the State of Iowa . . . engaged in performing a state governmental function under state law and at state expense."

Amendment's sovereign immunity does not permit a state to nullify the rights reserved and protected by Congress, acting pursuant to the Copyright and Patent Clause.

Although the Ninth Circuit has now held (*BV Engineering, supra*, Slip Op. at 12422 n.1) that *Mills Music* "has been overruled *sub silentio*" by this Court's decisions in *Atascadero* and *Welch, supra*, the conclusion that states are not immune from copyright suits remains "the better view" (*see Anderson* v. *Radford Univ., supra*, 633 F. Supp. at 1160 n.14, App. at 113a (quoting 3 M. Nimmer, *Nimmer on Copyright* §12.01[E.], at 12–21 (1985)); *see also* Note, *The Applicability of Eleventh Amendment Immunity Under the Copyright Acts of 1909 and 1976*, 36 Am. U.L. Rev. 163, 183 (1986) ("the analyses in *Mills Music* and *Johnson* represent a closer reading of the statutory language and intent, and are more consistent with the goals of copyright")). That is so, because — as we now show, and as both the Register of Copyrights and the dissenting opinion below concluded — *Atascadero* and *Welch* do not require that the reasonable expectations of copyright owners be crushed by foreclosing all damage recoveries against infringing states.

II.

THE FOURTH CIRCUIT'S DECISION IS NOT MANDATED BY ATASCADERO AND WELCH

Relying on *Atascadero* and *Welch*, the Fourth Circuit majority rejected *both* congressional abrogation *and* waiver implied from state action, as grounds for avoiding the Eleventh Amendment bar. In his dissent, Judge Boyle sharply disagreed with the majority, at least as to the abrogation theory. Certiorari should be granted to resolve this marked disagreement over the proper scope and application of *Atascadero* and *Welch* (*see Schlude* v. *Commissioner of Internal Revenue*, 372 U.S. 128, 130 (1963); *Wilkinson* v. *United States*, 365 U.S. 399, 401 (1961)). Indeed, in view of the conflict between the decision below and earlier precedent, and the broad effect of denying the copyright remedy entirely — which sets this case apart from all of this Court's previous Eleventh Amendment decisions — certiorari should be granted to review both the abrogation and waiver theories. For, as we now show

briefly, *Atascadero* and *Welch* do not mandate rejection of either theory in copyright cases.[12/]

A. Congress Abrogated the States' Eleventh Amendment Immunity in the Copyright Act of 1976

In seeking certiorari to review the Fourth Circuit's conclusion on abrogation, petitioner necessarily assumes that, when this Court decides *Pennsylvania* v. *Union Gas Co.* later this Term, it will uphold the power of Congress to abrogate when legislating under Article I of the Constitution.[13/] There is no reason why, if this Court in *Union Gas* affirms Congress' power to abrogate under the Commerce Clause of Article I, that holding would not also apply to the Copyright and Patent Clause of the same Article.[14/]

Assuming, then, that Congress has the power to abrogate Eleventh Amendment immunity when it legislates pursuant to the Copyright and Patent Clause, there can be no doubt that Congress intended to do so when it enacted the Copyright Act of 1976. Contrary to the majority's view below, the entirety of the statutory language of the Copyright Act meets the abrogation standard enunciated in *Atascadero* and *Welch*. For, as required by *Atascadero*, 473 U.S. at 243, and *Welch*, 107 S. Ct. at 2946, Congress' intent to make states amenable to

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[12/] In *BV Engineering, supra*, the Ninth Circuit also stated that its conclusion was mandated by this Court's decisions in *Atascadero* and *Welch*. It expressly noted at the end of its opinion that, while it found the arguments against state immunity in copyright cases to be "compelling," it was nevertheless "constrained by the Supreme Court's mandate" to uphold the Eleventh Amendment (Slip Op. at 12427).

[13/] As noted above, the majority of the Fourth Circuit did not decide this issue, but simply assumed Congress has the power. That is also what the Ninth Circuit did in *BV Engineering, supra*, Slip. Op. at 12422.

[14/] Conversely, should this Court hold that Congress cannot abrogate Eleventh Amendment immunity under Article I, that would, petitioner concedes, render the abrogation issue here moot. It would not, however, affect the separate waiver issue discussed below.

suit for copyright infringement can be found "in unmistakable language in the statute itself."

To begin with, the Act defines "an infringer of the copyright" as "[*a*]*nyone* who violates any of the exclusive rights of the copyright owner," and states that the "owner of an exclusive right under a copyright is entitled . . . to institute an action for *any* infringement of that particular right." 17 U.S.C. §§ 501(a) and (b) (emphasis added).[15/] Thus, as a starting point in the abrogation analysis, it is clear that in the 1976 Act, Congress created a remedy against a class of persons — "anyone" — which "literally include[s] States." *See Edelman* v. *Jordan*, 415 U.S. 651, 672–74 (1974).

Both the majority and dissenting opinions below agreed that this provision *alone* could not meet the *Atascadero* standard, but that the "inquiry must focus on the language of the statute as a whole" and may not be confined to § 501(a). 852 F.2d at 118, 125 (dissenting opinion); App. at 20a–21a, 61a–62a; *see also BV Engineering, supra*, Slip Op. at 12424.[16/] Thus, both opinions looked not only at the remedies sections of the Copyright Act, but also at the language of the various exceptions to copyright liability, applicable solely or principally to "governmental bodies." These various sections of the Act exempt from liability several specifically described activities undertaken "*by a*

[15/] Among the remedies expressly granted to the copyright owner against "*anyone*" who infringes is an action to recover either:

> (1) the copyright owner's actual damages and any additional profits of the infringer . . . or
>
> (2) statutory damages. . . .

17 U.S.C. § 504(a) (emphasis added).

[16/] This Court, too, has emphasized, and recently reaffirmed, that "[i]n expounding a statute, we must not be guided by a single sentence or member of a sentence, but look to the provisions of the whole law." *United States* v. *Heirs of Boisdore'*, 49 U.S. (8 How.) 113, 122 (1849); *see also Kelly* v. *Robinson*, 479 U.S. 36, 43 (1986) (quoting *Offshore Logistics, Inc.* v. *Tallentire*, 477 U.S. 207, 221 (1986)).

governmental body" which would otherwise subject that "governmental body" to a damage suit for infringement. *See* 17 U.S.C. §§ 110(2), (6), and (8), 111 (a)(2), 112(d), and 118(d)(3); App. at 119a-20a, 124a, 125a-26a, 130a, 131a-32a and 133a-34a.

Examination of the "statutory language" of these specific exemptions shows clearly that Congress intended states to be otherwise liable for copyright infringement. As Judge Boyle observed, if Congress had intended the states to be altogether immune from suit for every kind of infringement, as the majority held, then these carefully-worded — and, in some cases, extensively debated — specific exemptions for "governmental bodies" would have been unnecessary. (852 F.2d at 129; App. at 82a). Nevertheless, the majority could not find in them any clear indication of congressional intent to make states amenable to suit. Rather, it held, the phrase "governmental bodies" in this context was ambiguous, because it "could be read as applicable only to local governments or to actions by government officials so that the states' continued immunity would not render § 110(2) superfluous." (852 F.2d at 119; App. at 26a).[17/]

There are numerous flaws in the majority's dismissal of the "governmental body" exemptions as "ambiguous" — some of which are cogently exposed in Judge Boyle's dissent (852 F.2d at 127-29; App. at 73a-82a):

FIRST, of course, the "plain meaning" of the phrase "governmental bodies" surely includes the states and their agencies and instrumentalities. Ambiguity in this context can be found, if at all, only by a court disposed to find it. As Judge Boyle's dissent points out (852 F.2d at 128; App. at 77a), there is no apparent reason to read the statute in the restrictive manner adopted by the majority, and contrary to its plain meaning.

SECOND, the suggestion that "governmental bodies" could be read as applicable only to "actions by government officials,"

[17/] The Ninth Circuit in *BV Engineering* simply quoted this language from the majority's opinion and agreed with it. (Slip. Op. at 12426.)

rather than states or state instrumentalities, is belied by other parts of the same statute. Thus, as Judge Boyle's dissent points out (852 F.2d at 128; App. at 77a), Congress knew full well what language to use to limit an exemption to "officers or employees of governmental bodies" (17 U.S.C. § 110(2)(C)(iii)) when that was the intention. Conversely, as Judge Boyle also notes (*id.*), the entire text of the "state fair" exemption in section 110(6) makes clear that it applies only to governmental entities, and not to their officials or employees.

THIRD, if there could possibly be any ambiguity in the term "governmental bodies," the time-honored tool of statutory construction would be to seek help in the legislative history, which the majority entirely ignored. That is what the Seventh Circuit did in finding Eleventh Amendment abrogation in *In re McVey Trucking, Inc.*, 812 F.2d 311, 324 (7th Cir.), *cert. denied*, 108 S. Ct. 227 (1987), and what Judge Boyle did in his dissent. To be sure, the statutory language must be "unmistakable," but legislative history can still serve, as the Seventh Circuit held in *McVey*, to resolve "any lingering uncertainty" that Congress intended to create a cause of action against the states. *See McVey*, 812 F.2d at 324.

Here, the legislative history gives ample guidance, showing that the phrase "governmental bodies" was intended by Congress to have its plain meaning — *i.e.*, including the states — rather than the more restrictive meaning conjured up in the majority opinion. For example, as Judge Boyle's dissent points out (852 F.2d at 127-28; App. at 73a-75a), in discussing another exemption expressly referring to "any State or political subdivision of a State . . . ." (17 U.S.C. § 602; *see* pp. 17-18 *infra*), the House Report paraphrases that language as "*governmental body.*" H. R. Rep. No. 1467, 94th Cong., 2d Sess. at 167. *See also* House Comm. on the Judiciary, *Copyright Law Revision*, "Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law," 87th Cong., 1st Sess. at 129 (Comm. Print July 1961) (revision contains "nothing to prevent *governmental bodies, at least of the States*, from securing copyright . . . ." (emphasis added)); *Fitzpatrick* v. *Bitzer*, 427 U.S. 445, 449 & n.2 (1976) (phrase "governmental bodies" includes states under Title VII of the Civil Rights Act of 1964).

Beyond these specific explications of the phrase "governmental bodies," the legislative history of the Copyright Act of 1976 is replete with instances in which Congress focused on the extent to which states utilize copyrighted works and should be liable for infringement — as well as the reasons why states should, in limited instances, be exempt from such liability. For example, Senate subcommittee testimony outlined the pervasive use of copyrighted music at state fairs, and requested that a specific provision be narrowly tailored to permit this use.[18]/ Similarly, there was extensive testimony before Congress indicating the need for exemptions permitting certain limited uses of copyrighted material by libraries — including state institutional libraries[19]/ — and by public radio and television stations — including those owned and operated by state institutions. [20]/ Throughout the copyright revision process, there was never a word of doubt

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[18]/ Copyright Law Revision, Hearings on S. 597, Subcomm. on Patents, Trademarks and Copyrights, Comm. on the Judiciary, 90th Cong., 1st Sess. (1967) (letter of Sen. Frank J. Lausche) at 31; *id.* (statement of William B. Hartsfield, President, Southeastern Fair Ass'n) at 625 (emphasis added); *see also id.* (statement of William T. Collins, President, Outdoor Amusement Business Ass'n, Inc.) at 632; *id.* (letter from Sen. Jennings Randolph) at 1337; *id.* (letter from C. T. Sydenstricker, Secretary-Manager, State Fair of West Virginia) at 1338.

[19]/ Copyright Law Revision, Hearings on H.R. 4347, Subcomm. No. 3, House Comm. on the Judiciary, 89th Cong., 1st Sess. (1965) (statement of Dr. Charles F. Gosnell, Chairman, Comm. on Copyright Issues, Am. Library Ass'n) at 459; Copyright Law Revision, Hearings on S. 1361, Subcomm. on Patents, Trademarks and Copyrights, Senate Comm. on the Judiciary, 93rd Cong., 1st Sess. (1973) (statement of Stephen A. McCarthy, Exec. Dir., Ass'n of Research Libraries) at 97; *id.* (statement of Dr. Edmon Low, Chairman, Copyright Subcomm. of Am. Library Ass'n) at 101; Copyright Law Revision, Hearings on H.R. 2223, Subcomm. on Courts, Civil Liberties and the Admin. of Justice, House Comm. on the Judiciary, 94th Cong., 1st Sess. (1975) (statement of Frank McKenna, Exec. Director, Special Libraries Ass'n) at 213.

[20]/ Meeting on Preliminary Draft for Revised U.S. Copyright Law, House Comm. on the Judiciary, 87th Cong., 1st Sess. (1963) (statement of Eugene N. Aleinikoff, Nat. Educ. Television and Radio Center) at 144; Copyright Law Revision, Hearings on

(Continued)

expressed that, without the exemptions, state instrumentalities operating in these areas would be otherwise liable for infringement under the Act. Thus, taken as a whole, both the face of these exemptions and their legislative history remove "any lingering uncertainty" that Congress intended the states to be amendable to federal court copyright suits *except* where specifically exempted under the "governmental body" exceptions.

In addition to the "governmental body" exemptions, section 602 of the Act exempts from the prohibition against the unauthorized import of copyrighted materials acquired outside the United States copies or phonorecords which are imported "under the authority or for the use of . . . any State or political subdivision of a State." (17 U.S.C. § 602(a)(1); emphasis added.) Not even the Fourth Circuit majority could hold the phrase "Government of . . . *any State*" ambiguous, but it read that provision as exempting from liability not the states themselves, but only "private persons or public officials acting in their individual capacity who import copyright materials under governmental authority or for governmental use." (852 F.2d at 120; App. at 32a).

It is difficult to improve upon Judge Boyle's persuasive refutation of that construction of § 602. He said, in part (852 F.2d at 127; App. at 70a–71a):

> This restrictive interpretation, however, produces an anomalous result; state governments are immune under the eleventh amendment, state officials are immune under § 602, local governments are not immune at all, and local officials are immune

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(Continued)

S. 597, Subcomm. on Patents, Trademarks and Copyrights, Comm. on the Judiciary, 90th Cong., 1st Sess. (1967) (statement of Edwin G. Cohen, Exec. Dir., Nat'l Center for School and College Television) at 991–92; *id.* (statement of Chalmers H. Marquis, Exec. Dir., Educ. Television Stations, Nat'l Ass'n of Educ. Broadcasters) at 1013.

under § 602. This crazyquilt of liability and immunity cannot be what Congress intended.

A more logical and natural interpretation of § 602 is that it exempts federal, state and local governments and their officials acting in their official capacity. Officials acting in their official capacity are exempted by the language reading "under the authority . . . of . . . ." in § 602(a)(1). The governments, federal, state and local, are exempted by the language reading "for the use of . . . ."

Finally, the courts can "be certain of Congress' intent" (*Atascadero, supra*, 473 U.S. at 243) to make the states amenable to copyright damage suits from the very fact that it limited jurisdiction over such suits exclusively to the federal courts. Had Congress not intended abrogation, its exclusive jurisdiction provision would simply *deny the damage remedy entirely* against state infringers. But that result would contradict the time-honored common law precept that "[i]f the plaintiff has a right, he must of necessity have means of vindication if he is injured in the exercise or enjoyment of it. Right and remedy . . are reciprocal." *Ashby* v. *White*, 87 Eng. Rep. 808 (Q.B. 1702). As the Seventh Circuit held (post-*Atascadero*) in *Gomez* v. *Illinois State Bd. of Educ.*, 811 F.2d 1030 (7th Cir. 1987), "although a federal enactment must 'unequivocally' abrogate immunity, it may do so, not in so many words, but rather by its effect. For example, an abrogation may be found where *any other reading of the statute in question would render nugatory the express terms of the provision.*" *Id.* at 1036 (emphasis added).

That is exactly what would happen if the Copyright Act is read as lacking the requisite expression of congressional intent to abrogate. But, as shown above, such a reading of the statutory language is not logical, nor is it mandated by the "plain English" of the Act. Thus, when the Copyright Act is read *as a whole* — the statutory authorization for suit against "anyone" who infringes, the extensive state government exceptions to liability, and the grant of exclusive federal court jurisdiction — the courts can "be certain" that the Act subjects the states

to private damage suits. That was the conclusion of both the dissenter in the Fourth Circuit and of the Copyright Office — which is, of course, the governmental agency most expert in interpreting the Act.[21/] The latter was "convinced that Congress intended to hold the states responsible under the federal copyright law" (*Copyright Office Report* at 103). This Court should grant certiorari to make it plain that *Atascadero* and *Welch* do not mandate the opposite result.

B. There Has Also Been a Waiver of Eleventh Amendment Immunity

Certiorari should also be granted to review the Fourth Circuit's rejection of the other exception recognized by this Court in *Atascadero* and *Welch* — waiver of Eleventh Amendment immunity. As this Court made clear in *Atascadero*, there are *two* ways in which such waiver may be effected: (1) by express consent of the state, such as in a state constitutional or statutory authorization or (2) as a condition imposed by Congress upon state participation in a particular activity regulated by Congress. *Atascadero*, 473 U.S. at 238 n.1; *see also WJM, Inc.* v. *Massachusetts Dep't of Public Welfare*, 840 F.2d 996, 1002–03 (1st Cir. 1988); *Collins* v. *Alaska*, 823 F.2d 329, 331–32 (9th Cir. 1987). That second kind of waiver applies here: by affirmatively entering the copyright sphere — both through its ownership of copyrights and its infringement of appellant's copyright — the Commonwealth of Virginia has consented to suit.

The Fourth Circuit majority did not separately analyze the waiver question, because it believed that the abrogation and waiver doctrines posed "a common issue" of congressional intent, and thus that "the same basic test of congressional intent" [*i.e.*, *Atascadero*'s stringent requirement of an "intention unmistakably clear in the language of the statute"] "applies to both." (852 F.2d at 117; App. at 12a-

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[21/] This Court has indicated that it would ordinarily give deference to the Copyright Office's construction of the Act. *DeSylva* v. *Ballantine*, 351 U.S. 570, 577–78 (1956); *see also Cablevision Systems Development Co.* v. *Motion Picture Ass'n of America, Inc.*, 836 F.2d 599, 609(D.C. Cir. 1988), *cert. denied*, 108 S. Ct. 2901 (1988).

13a.) But if the *Atascadero* test were equally applicable to both the abrogation and waiver doctrines, as the majority believed, there would be no need for two separate theories; each Eleventh Amendment case would be resolved the same way — by applying the *Atascadero* test to the language of the relevant act of Congress.

By granting certiorari, this Court can make it clear that the test for abrogation and waiver are not one and the same. The implied waiver concept was first enunciated by this Court in *Parden* v. *Terminal Ry.*, 377 U.S. 184 (1964), which did not enunciate the kind of stringent test for discerning congressional intent to *abrogate* that was later adopted in *Atascadero*. This Court strongly implied in *Welch* that the two tests are different, when it overruled *Parden* only to the extent that it was "inconsistent with the requirement that an abrogation of Eleventh Amendment immunity by Congress must be expressed in unmistakably clear language." 107 S. Ct. at 2948: (emphasis added).[22/]

In applying the waiver doctrine, there is less need for the kind of stringent test required in *Atascadero* for abrogation, because amenability to suit does not depend solely on congressional intent: the state's affirmative action implying consent is also a required element of the formula. Thus, rather than the stringent *Atascadero* standard, the appropriate test for a finding of waiver is the one applied by the First Circuit in *WJM* (840 F.2d at 1003): has the state been put "on

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22/ The test set forth in *Parden* to determine whether a state has waived its Eleventh Amendment immunity was not overruled, and has been consistently applied by this Court. *See, e.g., Edelman* v. *Jordan*, 415 U.S. 651 (1974); *Employees* v. *Missouri Dep't of Pub. Health and Welfare*, 411 U.S. 279 (1973); *see also id.* at 282 (*Parden* "turned on the question of waiver"). Indeed, the continuing vitality of the *Parden* waiver standard has been noted by this Court, *see, e.g., County of Oneida* v. *Oneida Indian Nation, supra*, 470 U.S. at 252 n.26 (1985), and at least one lower court, *Brotherhood of Locomotive Eng'rs* v. *New Jersey Transit Rail Operations, Inc.*, 618 F. Supp. 1456, 1458 (S.D.N.Y. 1985) ("[t]he *Atascadero* dissenters, in their reference to *Parden* . . . did not perceive the majority as having overruled that case"). In *Atascadero* itself, this Court applied the test originally enunciated in *Parden* to determine that the state had not waived its Eleventh Amendment immunity under section 504 of the Rehabilitation Act, 29 U.S.C. § 794. *See* 473 U.S. at 246–47.

notice" that "if it chooses to enter the federal government's exclusive . . . preserve . . . it must pay a price: a partial waiver of its sovereign immunity"?

In the case of copyright infringement, that question must be answered affirmatively. There is a crucial distinction between "a state's mere participation in a federal program, accepting or administering federal funds thereunder," which is not sufficient to establish consent to suit (*Atascadero*, 473 U.S. at 246–47; *Edelman* v. *Jordan*, 415 U.S. 651, 673 (1974)), and a state's affirmative act entering an exclusively federal preserve — such as Massachusetts' filing of a bankruptcy claim in *WJM*, Alabama's operation of a railway in *Parden*, or Virginia's holding of copyrights and its purposeful use of Anderson's copyrighted photographs here. Knowing use of copyrighted materials is precisely the kind of affirmative proprietary activity that Congress intended to reach under the copyright laws. The 1976 Copyright Act and its legislative history leave no room for doubt that Congress intended to put the states "on notice" that they were subject to liability for copyright infringement. The waiver doctrine thus fits state infringement of copyrights to a tee.

III.

GIVING IMMUNITY TO STATE INFRINGERS DOES NOT FURTHER THE PURPOSE OF THE ELEVENTH AMENDMENT

The Fourth Circuit did not stop to consider whether rigid application of the *Atascadero* test in copyright cases is even consistent with the basic purpose of the Eleventh Amendment. But it seems clear that closing the doors of the federal courts — and thus all courts — to damage suits against state copyright infringers does nothing to further the concerns underlying the Eleventh Amendment. The Amendment was never intended as a limitation on Congress' plenary powers under the Copyright and Patent Clause. Rather, it arose out of a controversy over the scope of the early federal courts' power to adjudicate certain interstate contract claims. Thus, the Amendment finds its origins in a 1793 decision in which this Court assumed original jurisdiction over a

suit brought by a citizen of South Carolina against the State of Georgia. *Chisholm* v. *Georgia*, 2 U.S. (2 Dall.) 419 (1793). Federal court litigation by citizens of one state against another sovereign state did not comport with the concepts of federalism prevalent in the earliest days of the republic, and the *Chisholm* decision thus "created such a shock of surprise that the Eleventh Amendment was at once proposed and adopted." *Monaco* v. *Mississippi*, 292 U.S. 313, 235 (1934).

None of those original sovereign immunity concerns — nor those enunciated by this Court in nearly 200 years of Eleventh Amendment jurisprudence — would be furthered by "allow[ing the] states to violate federal copyright laws with virtual impunity" (*BV Engineering*, *supra*, Slip Op. at 12427). As this Court noted in *Parden*, "[t]he sovereign power of the states is necessarily diminished to the extent of the grants of power to the federal government in the Constitution." 377 U.S. at 191 (quoting *United States* v. *California*, 297 U.S. 175, 184 (1936)). Therefore, to the extent that Congress has exercised the power granted to it in the Constitution to regulate copyrights and patents, the states have relinquished their sovereign status in that arena. *See Goldstein* v. *California*, *supra*, 412 U.S. at 552; *Employees* v. *Missouri Dep't of Pub. Health and Welfare*, 411 U.S. 279, 288–89 (1973) (Marshall, J., concurring in the result). Prior to 1976, the states never had any legitimate expectation that their legislatures or courts would have a role to play in the development or enforcement of the copyright laws protecting published works. The exclusivity of congressional (and thus federal court) dominion was assured when the 1976 Act abolished common law copyrights for unpublished works (17 U.S.C. § 301(a)), thus preempting entirely any role for state law in the copyright realm. In sum, as the Ninth Circuit pointed out in *BV Engineering*, *supra*, Slip Op. at 12427, to the extent the Eleventh Amendment evinces "a concern for maintaining a balance of power between state and federal courts," that balance cannot be affected in copyright cases, because the state courts do not have any jurisdiction in this area — "the choice is not between the federal forum and the state forum — it is between the federal forum and *no* forum." (Emphasis in original).

It is thus no coincidence that this Court has never recognized the Eleventh Amendment as a bar to relief when, as in copyright cases, federal court jurisdiction is exclusive. Indeed, in many of this Court's Eleventh Amendment opinions, the alternative of a state court forum to enforce federally created rights was a significant factor in its analysis. *See, e.g., Parden* v. *Terminal Ry., supra*, 377 U.S. at 190 (1964); Employees, *supra*, 411 U.S. at 293–94 (Marshall, J., concurring in the result); *Atascadero, supra*, 473 U.S. at 240 n.2. In light of the foregoing, the Copyright Act should not easily be read to create specific rights with no means of enforcing those rights when a state is the infringing party. The same Congress which took such pains to carve out limited exceptions to liability for the states cannot have meant, in the same statute, to immunize the states entirely.

It is also significant that the states would not be excessively burdened by being held amenable to copyright infringement actions. The "enormous fiscal burden on the states" if they were subject to FLSA suits was one reason for this Court's reticence to find abrogation or waiver in *Employees*. (411 U.S. at 284–85.) Under the Copyright Act, however, states need only pay royalties for the use of copyrighted material, a task which states normally comply with at present. Thus, as the Ninth Circuit recognized in *BV Engineering, supra*, Slip Op. at 12426, states can avoid a "drain on state treasuries . . . simply by complying with the federal copyright laws." *See also Johnson* v. *University of Virginia*, 606 F. Supp. 321, 323 n.2 (W.D. Va. 1985).

The goal of any judicial construction of a congressional enactment is "to construe the language [of the statute] so as to give effect to the intention of Congress.'" *McVey*, 812 F.2d at 325 (quoting *United States* v. *American Trucking Ass'ns*, 310 U.S. 534, 542 (1940)). As shown above, both the language of the statute as a whole and its legislative history leave no room for doubt that Congress intended the states to be amenable to damage suits under the Copyright Act. As noted, that was the view of the Register of Copyrights in his recent Report to Congress. *Copyright Office Report* at 99–103. *See also* Note, *The Applicability of Eleventh Amendment Immunity Under the Copyright Acts of 1909 and 1976*, 36 Am. U.L. Rev., *supra*, at 183 (1986). Any other reading of the

Copyright Act's unmistakable language would destroy the broad and uniform system of federal law that Congress so carefully and specifically crafted.

In sum, the necessary effects of the decision below are to undermine the Constitution's design that Congress was to create a uniform system of copyrights and patents, to impede Congress' encouragement of creative endeavor and, wherever state use is involved, to frustrate the widespread reliance of those in the creative process on the Copyright Act as their protection against "anyone" who would expropriate their creations without payment. Since none of those effects furthers the concerns underlying the Eleventh Amendment, this Court should grant certiorari and reverse the decision below.

CONCLUSION

In light of the clear congressional intent to subject states to suit for copyright infringement, and the severe economic impact of stripping writers, artists, composers and publishers of the right to sue infringing states for damages, this Court should grant a writ of certiorari to review the Fourth Circuit's decision.

Dated: October 14, 1988

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APPENDIX TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

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852 F.2d 114

RICHARD ANDERSON PHOTOGRAPHY,
Plaintiff-Appellant,

v.

Deborah BROWN; Radford University,
Defendants-Appellees,

and

VISITORS OF RADFORD UNIVERSITY;
Bernice Thieblot; Armand
Thieblot, Defendants,

v.

NATIONAL MUSIC PUBLISHERS' ASSOCIATION,
INC.; American Society of Composers,
Authors and Publishers; Broadcast
Music, Inc.; Music Publishers'
Association of the United States,
Inc.; The Songwriters Guild of
America; Volunteer Lawyers for the
Arts, Inc.; Barbara Ringer; John M.
Kernochan; William F. Patry;
Association of American Publishers;
Association of American University
Presses, Inc.; Information Industry
Association, American Intellectual
Property Law Association, Amici
Curiae.

No. 87-1610

United States Court of Appeals,
Fourth Circuit.

Argued Nov. 2, 1987.
Decided July 20, 1988.

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Barbara Ringer, Washington, D.C., John M. Kernochan, New York City, and William F. Patry, Washington, D.C., in support of appellant Richard Anderson Photography.

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Before PHILLIPS and CHAPMAN, Circuit Judges, and BOYLE, United States District

Judge for the Eastern District of North Carolina, sitting by designation.

JAMES DICKSON PHILLIPS, Circuit Judge:

This appeal presents the questions whether the eleventh amendment provides immunity to a state educational institution, its governing board, and one of its officials, as sued in her official capacity, on a claim for damages under the Copyright Act of 1976, 17 U.S.C. § 101 *et seq.* (the Act), and whether state law provides immunity to the state official as sued in her individual capacity. The district court found both eleventh amendment and state law immunity and dismissed all the claims. We affirm the dismissals on eleventh amendment grounds as to the state institution and its board and the official in her official capacity, though

for different reasons than those given by the district court. We reverse the dismissal of the claim against the state official in her individual capacity on state law immunity grounds and remand that claim for further proceedings.

I

In 1981, Radford University, an educational instrumentality of the Commonwealth of Virginia (Radford), contracted with the North Charles Street Design Organization (NCSDO) of Baltimore, Maryland, to produce a student prospectus. NCSDO in turn contracted with the plaintiff-appellant in this action, Richard Anderson Photography, Inc. (Anderson), to provide the photographs for use in Radford's 1982 student prospectus. Anderson took and obtained

copyrights for a large set of photographs, some of which ultimately were published in the 1982 prospectus, per the contract.

At some point, Anderson concluded that Radford, through defendant-appellee Deborah Brown, Radford's Director of Public Information and Relations, was making unauthorized use of the photographs in violation of Anderson's exclusive rights under 17 U.S.C. §§ 106(1), (2), (3) and (5). Anderson then brought this action against Radford, its governing board, and Brown, alleging such a violation and seeking injunctive and monetary relief. When Radford returned the photographs, Anderson dropped the claim for injunctive relief but continued to pursue the claim for damages against all the named defendants.

The defendants then jointly moved for dismissal of the action on the basis of their eleventh amendment immunity as, respectively, instrumentalities and an official of the state. Anderson responded by urging alternatively that Congress in the Copyright Act had directly abrogated the states' eleventh amendment immunity to suits under that Act, or that the Commonwealth of Virginia had constructively consented to being sued for violations of the Act by participating, through the use of copyright materials, in an activity regulated by Congress.

The district court dismissed the claims against Radford, its Board, and Brown insofar as she was sued in her official capacity. Specifically the court held that Congress did not have the power to abrogate the states' eleventh

amendment immunity except under section 5 of the fourteenth amendment, a source of power not available in its enactment of the Copyright Act. The court did not address the further question whether, had the power existed, Congress had effectively exercised it. The court also rejected Anderson's alternative claim that the Commonwealth had constructively consented to suit, thereby waiving its eleventh amendment immunity by participating, through use of copyright materials, in congressionally regulated activity. *See Richard Anderson Photography, Inc. v. Radford Univ.*, 633 F. Supp. 1154, 1158-60 (W.D. Va. 1986).

The district court, however, then *sua sponte* raised and invited briefing on the issue whether Brown might be liable on Anderson's claim in her individual

capacity. In response, Brown contended that because in the conduct charged to her she was acting within the scope of her official authority, she could only be sued in her official capacity, in which capacity she had properly been held immune to suit under the eleventh amendment. Anderson responded that because Brown's conduct was allegedly illegal, she could not be considered as acting within her official authority, so that she was exposed to individual liability free of the eleventh amendment's immunity.

The district court, however, rejected both parties' contentions on this point and held, *sua sponte*, that Brown could be sued in her individual capacity for the copyright violation charged to her, but that in that capacity she was entitled,

under Virginia state law, to the immunity provided by Virginia law to state officials in the performance of discretionary functions. On this basis, the court dismissed the claim against Brown in her individual capacity.

This appeal by Anderson followed.

II

With respect to its claims against Radford, the Radford Board, and Brown in her official capacity, hence effectively against the state, Anderson renews its arguments that the eleventh amendment provides no immunity. Two alternative theories are advanced.

The first theory is that Congress has directly abrogated the states' eleventh amendment immunity in its enactment of the Copyright Act. This

argument in turn has two elements: first, that Congress has power under the Copyright and Patent Clause of the United States Constitution, art. I, § 8, cl. 8, directly to abrogate the immunity of nonconsenting states to suits under the Act; and second, that Congress has effectively done so in the Copyright Act.

The second theory is that here the state, in any event, has constructively consented to suit, thereby impliedly waiving its immunity, by participating in federally regulated conduct through its own copyright activities.[1/]

While these are conceptually different theories, they pose, under current

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1/ There is no contention that the state has expressly waived its immunity by statute or constitution.

doctrine, a common issue: whether Congress has effectively expressed its intention either directly to abrogate immunity, without regard to the states' consent, or to exact "constructive consent" to suit, hence, an "implied waiver" of immunity from the states as a condition of their participation in federally regulated, here copyright, activity.[2/] Because the same basic test

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2/ By referring to this theory of eleventh amendment override alternatively as "indirect abrogation" or "exacted consent," we simply draw on still other ways to describe what has come more commonly to be described interchangeably as "constructive consent" or "implied waiver." Both of these latter descriptives refer to the states' ultimate conduct which perfects the override by this particular means. The former descriptives refer instead to the congressional action

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of congressional intent applies to both, *see Atascadero State Hosp. v. Scanlon*, 473 U.S. 234, 247, 105 S. Ct. 3142, 3149-50, 87 L.Ed.2d 171 (1985); *Welch v. State Dept. of Highways*, __ U.S. __, 107 S. Ct. 2941, 2947-48, 97 L.Ed.2d 389 (1987), and because resolving that issue may avoid the need to address any more fundamental issues of Congress'

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which sets this process in motion. All serve equally well. The virtue of the descriptives that refer to the congressional action is that they emphasize the critical point here in issue, whether Congress has indeed taken the critical initiating step from which "implied waiver" or "constructive consent" by the states may have followed. "Indirect abrogation" by "exacting constructive consent" serves also to distinguish this process from "direct abrogation without consent." Obviously no substantive difference is intended.

constitutional power to abrogate, *see Ashwander v. Tennessee Valley Authority*, 297 U.S. 288, 347, 56 S. Ct. 466, 483, 80 L.Ed. 688 (1936) (Brandeis, J., concurring), we look first to the issue of congressional intent. *See Welch*, 107 S. Ct. at 2946-47.

That test, as recently refined by the Supreme Court in a series of critical decisions, is a most stringent one, couched deliberately in terms of constraints both upon the legislative power and the judicial interpretive process. Specifically, the Court has now held that because of the "fundamental nature of the interests implicated by the Eleventh Amendment," *Atascadero*, 473 U.S. at 242, 105 S. Ct. at 3147, and "the vital role of the doctrine of sovereign immunity in our federal system," *Pennhurst State*

School and Hosp. v. Halderman, 465 U.S. 89, 99, 104 S. Ct. 900, 907, 79 L.Ed.2d 67 (1984) (*Pennhurst II*):

> Congress may abrogate the States' constitutionally secured immunity from suit in federal court only by making its intention unmistakably clear in the language of the statute . . . [and] it is incumbent upon the federal courts to be certain of Congress' intent before finding that federal law overrides the guarantees of the Eleventh Amendment.

Atascadero, 473 U.S. at 242-43, 105 S. Ct. at 3147; *see also Welch*, 107 S. Ct. at 2946 (applying *Atascadero* test). As the Court sees it, the dual constraints are interdependent: "The requirement that Congress unequivocally express this intention in the statutory language ensures such [judicial] certainty." *Atascadero*, 473 U.S. at 243, 105 S. Ct. at 3147.

Applying the *Atascadero/Welch* test, we hold that, laying aside all questions of its constitutional power to abrogate by either means, Congress has not in the Copyright Act so unequivocally expressed its intention to abrogate either directly, without regard to consent, or indirectly by exacting consent as a condition of participation, as to allow us to find an override of the eleventh amendment immunity here invoked by the state defendants.

Though, as indicated, the basic inquiry into congressional intent is the same under both the "direct abrogation" and "implied waiver" theories of eleventh amendment override, there are differences between the two that require separate inquiries. We take the theories in the order stated.

A

In considering whether Congress has unequivocally expressed an intention in the Copyright Act directly to abrogate eleventh amendment immunity, we start with the core substantive, remedial, and jurisdictional provisions of the Act as the most likely sources of any such expression.

Section 501 creates the basic right of action. It provides that the registered owner of any of the exclusive rights conferred under the Copyright Act, *see* 17 U.S.C. §§ 106-118, may institute an action for infringement against an infringer of any of those rights. *See* 17 U.S.C. § 501(b). Section 501 describes an infringer as follows:

> (a) *Anyone* who violates any of the exclusive rights of the

> copyright owner as provided by sections 106 through 118, or who imports copies or phonorecords into the United States in violation of section 602, is an infringer of the copyright.

(Emphasis added.)

Sections 504 and 505 provide for monetary remedies against an infringer in the form of actual or statutory damages, costs and attorney's fees, except as against the United States or its officers. Section 502 provides for injunctive relief: "[a]ny court having jurisdiction of a civil action arising under" the Act may "grant temporary and final injunctions . . . as it may deem reasonable to prevent or restrain infringement of a copyright." Additionally, § 301 provides that any rights equivalent to those governed by the Act existent under

the common law or statutes of any state are preempted.

The Act does not itself provide for federal jurisdiction over suits brought pursuant to its provisions. Because of the need for national uniformity of copyright law, however, Congress has separately provided for exclusive federal jurisdiction over civil actions arising under the Act. *See* 28 U.S.C. § 1338(a).

It is clear, therefore, that the effect of these core substantive, remedial and jurisdictional provisions is to provide a general right of action, exclusively maintainable in the federal courts, under which both monetary and injunctive relief may be obtained against "anyone who violates any of the exclusive rights of the copyright owner." 17 U.S.C. § 501(a). Anderson's basic

argument is that this general authorization for enforcement actions against "anyone" sufficiently expresses Congress' intent that the states, as entities necessarily included within the descriptive "anyone," shall be subject to suit for the full range of remedies provided by the Act. To this there is a short and decisive response: such a general authorization, for suit against "anyone" in federal court is not, *in itself,* a sufficiently clear and unequivocal indication of congressional intent to subject unconsenting states to suits for money damages in federal court. *See Welch,* 107 S. Ct. at 2947; *Atascadero,* 473 U.S. at 246, 105 S. Ct. at 3149.

This does not, however, end the matter. Anderson rightly contends that our inquiry must focus on the language of

the statute as a whole. We agree that we are not limited in our inquiry to the core provisions authorizing suit and generally describing those who may sue and be sued to enforce the Act's substantive rights. "Rather, we [must] seek to understand a given provision by determining how it fits into the larger statute of which it is a part." *In re McVey Trucking*, 812 F.2d 311, 326 (7th Cir. 1987). We therefore look to other provisions of the Act which Anderson and associated amici contend make congressional intention to abrogate sufficiently clear when read in conjunction with the basic provisions just discussed.3/

3/ We note that several courts that recently have found the language of (Continued)

The provisions on which Anderson relies are 17 U.S.C. §§ 107, 108, 110(2), 110(6), 111(a), 112, 118(d)(3), 601 and 602. We consider them in order.

Section 107 provides for certain specified uses of copyrighted materials that will not be considered as infringements. *See* 17 U.S.C. § 107. These "fair uses" include reproduction of multiple copies for classroom use by teachers. Anderson argues that this provision is

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the Copyright Act insufficient to abrogate the states' eleventh amendment immunity seemingly have confined their analysis to the language of § 501. *See, e.g., BV Eng'g, Inc. v. University of California, Los Angeles,* 657 F. Supp. 1246, 1250 (C.D.Cal. 1987); *Woelffer v. Happy States of America, Inc.,* 626 F. Supp. 499, 504 (N.D.Ill. 1985). We agree with Anderson that the broader inquiry is required.

superfluous if state schools are to be considered immune from suit. This argument is without merit not only because, as we discuss below, a teacher's immunity from suit is not coextensive with that of the state, but also because the limitations in § 107 can be read as applying to teachers in local school districts that might not, in any event, share the states' eleventh amendment immunity. *See Mt. Healthy City School Dist. Bd. of Educ. v. Doyle*, 429 U.S. 274, 280-81, 97 S. Ct. 568, 573-73, 50 L.Ed.2d 471 (1977). Likewise, the explicit limitations on a copyright holder's exclusive rights pertaining to use of the copyrighted work by "libraries and archives" found in § 108, can be read as applicable to private and local institutions and therefore are not

superfluous absent congressional abrogation of the states' eleventh amendment immunity.

Anderson also relies heavily on § 110(2) of the Copyright Act which includes as noninfringing activities the performance or display of a "nondramatic literary or musical work" if:

> (A) the performance or display is a regular part of the systematic instructional activities of a governmental body or a nonprofit educational institution; and
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> (B) the performance or display is directly related and of material assistance to the teaching content of the transmission; and
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> (C) the transmission is made primarily for--

> (i) reception in classrooms or similar places normally devoted to instruction, or
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> (ii) reception by persons to whom the transmission is directed because their disabilities or other special circumstances prevent their attendance in classrooms or similar places normally devoted to instruction, or
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> (iii) reception by officers or employees of governmental bodies as a part of their official duties or employment.

Anderson contends that use of the phrase "governmental bodies" in this provision is a sufficiently clear indication of congressional intent to subject the states to damage suits for copyright

infringement in federal court. The argument is that if it were otherwise, Congress would not have excepted some of the states' activities from liability under § 110(2) through use of the phrase "governmental bodies." We conclude, however, that the phrase "governmental bodies" in this context has the same ambiguity for the purpose at hand as do the provisions in §§ 107-108. Clearly the phrase could be read as applicable only to local governments or to actions by government officials so that the states' continued immunity would not render § 110(2) superfluous.

The Seventh Circuit's recent decision in *In re McVey Trucking,* 812 F.2d 311 (7th Cir.1987), is not to the contrary. There, in the course of determining that the Bankruptcy Code abrogates

the states' eleventh amendment immunity, the court concluded that the phrase "governmental units" contained in § 106(c) of the Code, was intended to include the states as the targets of suit, hence expressly to have abrogated immunity. *Id.* at 326. But the *McVey* court reached this conclusion by looking to a definitional provision of the Code that defined "governmental unit" as including states. *Id.* While there is some question whether "clear and unequivocal intent" can properly be found through reference to such definitional provisions, *see United States v. Union Gas Co.*, 832 F.2d 1343, 1347-50 (3d Cir. 1987), it is not necessary for us to consider that issue here. Nowhere in the definitional provisions or elsewhere in the body of the Copyright Act is the phrase "governmental bodies"

defined explicitly as including states. Section 110(2) therefore fails to support Anderson's claim that the Act directly abrogates the states' eleventh amendment immunity. For the same reasons, §§ 110(6), 110(8), 111(a), 112, and 118(d)(3), also using the phrase "governmental body" without explicit reference to states as distinct from local governments, fail to support Anderson's argument.

Anderson next argues that § 601 of the Act, a provision that lapsed on July 1, 1986, would be superfluous if Congress had not intended the states to be subject to damage suits in federal court under the Copyright Act. Section 601 merely prohibited the importation into the United States of predominantly nondramatic literary works not published in the United States or Canada. *See* 17

U.S.C. § 601(a). Section 601 was tied to § 501 in that a plaintiff's illegal importation under § 601 was a complete defense to plaintiff's suit for infringement "with respect to all of the nondramatic literary material comprised in the work." 17 U.S.C. § 601(d). Section 601(b)(3) provided, however, that the defense did not apply, in pertinent part, "where importation is sought under the authority or for the use, other than in schools, of the Government of the United States or of any State or political subdivision of a State." 17 U.S.C. § 601(b)(3). Laying aside the point that a lapsed statutory provision lacks persuasive force, we decline to conclude that by disallowing an otherwise valid defense to an infringement action when the allegedly infringed work's

importation was "sought under the authority or for the use . . . of any State," *id.*, Congress evidenced as intent to subject the state *itself* to an action for damages for infringement in federal court.

Anderson's final argument draws on § 602 of the Act, which provides, in pertinent part, that:

> (a) Importation into the United States, without the authority of the owner of copyright under this title, of copies or phonorecords of a work that have been acquired outside the United States is an infringement of the exclusive right to distribute copies of phonorecords under section 106, actionable under section 501. This subsection does not apply to--

> (1) importation of copies or phonorecords under the authority or for the use of the Government of the United States or of any State or political subdivision of a State, but not including copies or phonorecords for use in schools, or copies of any audiovisual work imported for purposes other than archival use.

17 U.S.C. § 602(a)(1).

The argument is that the exception in subdivision (1) relating to importations "under the authority or for the use of . . . any state" would not be required were states already subject to general immunity. If the subdivision (1) exception referred to importation "by" any state rather than "under the authority or

for the use of . . . any State," this provision might support Anderson's argument. As it stands, however, the exception can most logically, certainly arguably, be read as exempting from liability only those private persons or public officials acting in their individual capacity who import copyright materials under governmental authority or for governmental use. Section 601 is not, therefore, an unequivocal indication of Congress's intent to subject the state itself to an action for damages for infringement.

For these reasons, we hold that the language of the Copyright Act, considered as a whole, does not clearly and unequivocally indicate Congress's intent to create a cause of action for money damages enforceable against the states in

federal court, thereby directly abrogating the states' eleventh amendment immunity.

B

Anderson's alternative theory is, as indicated, that the Commonwealth of Virginia has "constructively consented" to suit and thereby "impliedly waived" its immunity to suits for damages under the Copyright Act by its own participation in the conduct federally regulated by that Act. In support of this theory, Anderson and its associated amici rely on the doctrine of "implied waiver by participation" as applied most critically in *Parden v. Terminal Ry. of Alabama Docks Dept.*, 377 U.S. 184, 84 S. Ct. 1207, 12 L.Ed.2d 233 (1964). In *Parden*, the Court did hold that general language

in the FELA, 45 U.S.C. §§ 51-60, making that Act applicable to "every common carrier" engaged in interstate commerce, permitted an injured employee of a state-owned railroad to sue the state for money damages under the FELA. "Implied waiver" of the state's eleventh amendment immunity was found in its participation, as owner and operator of a railroad engaged in interstate commerce, in conduct regulated by the FELA, in the face of language in that Act which, without definitional limitation, exposed to suits for damages "every common carrier" so engaged.

Were this holding in *Parden* still authoritative, Anderson's argument might well prevail. There is no question but that the state here has participated, as truly as did the state in *Parden*, in

federally regulated conduct. The general language in § 501 of the Copyright Act defining as an "infringer" subject to suits for damages "anyone" who violates that Act's substantive provisions would seem as inclusive of states as was the descriptive "every common carrier" which was held in *Parden* to have that effect.

But *Parden* is not still authoritative on the critical point of Anderson's alternative contention. Some years after *Parden*, the Court in *Edelman v. Jordan*, 415 U.S. 651, 94 S. Ct. 1347, 39 L.Ed.2d 662 (1974), raised cautions about too freely using notions of "constructive consent" through participation in federally regulated conduct to find the states' eleventh amendment immunity overridden. *Id.* at 673, 94 S. Ct. at 1360 ("not a doctrine commonly associated

with the surrender of constitutional rights"). Later, in *Atascadero State Hosp. v. Scanlon*, 473 U.S. 234, 105 S. Ct. 3142, 87 L.Ed.2d 171 (1985), the Court gave even harder content to the *Edelman* caution, holding that to find the eleventh amendment immunity overridden by this means, there must be not only an unequivocal indication of state participation in federally regulated activity, *id.* at 238 n. 1, 105 S. Ct. at 3145 n. 1, but a congressional expression of intent to condition participation upon consent as clear and unequivocal as that required to abrogate directly the immunity of unconsenting states. *Id.* at 247, 105 S. Ct. at 3149-50. After *Atascadero*, it was obvious that that decision's stringent test for finding "implied waiver" by "constructive consent" drew *Parden's* much

looser approach in serious question,[4/] and in fairly short order the Supreme Court resolved the matter by confirming the *Atascadero* test as the authoritative one. In *Welch v. State Dept. of Highways & Pub. Transp.*, __ U.S. __, 107 S. Ct. 2941, 97 L.Ed.2d 389 (1987), one question was whether a state had constructively consented to suits in federal courts under the Jones Act, 46 U.S.C. App. § 688, by operating a ferry under conditions invoking the provisions of that Act. Directly in issue--in fact dispositive of the point--was whether *Parden*, which had found immunity waived for FELA purposes by the state's operation of a

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4/ A point noted by the district court as it considered the question before the decision in *Welch*.

railroad, controlled to dictate the same result under the closely related (indeed borrowed) Jones Act provisions as applied to state employed seamen. The *Welch* court held flatly that though *Parden* had not before been expressly overruled, several decisions, culminating in *Atascadero*, had now left "no doubt that [its] discussion of congressional intent to negate Eleventh Amendment immunity is no longer good law." *Welch,* 107 S. Ct. at 2948. The more stringent test most recently applied in *Atascadero* was reaffirmed and *Parden* was expressly overruled "to the extent . . . inconsistent with the requirement that an abrogation of Eleventh Amendment immunity by Congress must be expressed in unmistakably clear language." *Id.*

Here, the critical language of the Copyright Act, as analyzed in Part II.A above, no more unequivocally expresses an intention condition participation by the states upon their constructive consent to suit than it does to effect a direct abrogation of their immunity without regard to their actual or constructive consent. *Cf. Welch,* 107 S. Ct. at 2946-48 (applying parallel tests of congressional intent to both "direct abrogation" and "constructive consent" contentions); *Atascadero,* 473 U.S. at 242-47, 105 S. Ct. at 3147-50 (same).

For these reasons, we hold that there has been no implied waiver of eleventh amendment immunity by the Commonwealth's participation in federally regulated copyright activity.

III

As indicated, after holding, as we have now affirmed, that the claim against Brown in her official capacity was barred by the eleventh amendment, the district court ruled further, *sua sponte*, that she was also immune to the claim in her individual capacity, on the basis of the immunity accorded by state law to state officials sued in their individual capacities for conduct taken in the performance of discretionary functions. Notwithstanding this ruling according her absolute immunity in her individual capacity, Brown continues to maintain on this appeal, as she has throughout, that on a more fundamental basis the claim against her is one that can only be considered one in her official capacity,

as to which she enjoys eleventh amendment immunity.

Both theories of immunity being properly before us, whether as raised by Brown as appellant or as invoked *sua sponte* by the district court, we consider them in turn.

A

We agree with the district court that the circumstances do not warrant treating the claim against Brown as necessarily only one in her official capacity. We hold instead, with the district court, and against Brown's contention, that the claim may properly be considered one against her in her individual capacity.

There are of course circumstances under which a claim against a state

official for monetary relief can only be considered as one in the defendant's official capacity, hence one effectively against the state and therefore subject to eleventh amendment immunity. The test is whether "the judgment sought . . . would require an official to do that which he could only do by virtue of the fact that he is an official, that *quoad hoc* he is the State." *Larson v. Domestic & Foreign Commerce Corp.*, 337 U.S. 682, 714, 69 S. Ct. 1457, 1474, 93 L.Ed. 1628 (1948) (Frankfurter, J., dissenting); *see also Edelman,* 415 U.S. at 664-65, 94 S. Ct. at 1356-57 (action to compel state official to release withheld welfare benefits is effectively one seeking monetary relief from the State itself; hence barred by the eleventh amendment).

The claim against Brown here is obviously not of that character. Brown could obviously pay a judgment for money damages independently of her status as a state official, and without any consequences to the state's fisc. *See American Civil Liberties Union, Inc. v. Finch,* 638 F.2d 1336, 1341 (5th Cir. 1981). The mere fact that her conduct was undertaken in the course of her state employment does not of course relieve her of individual liability, even if her employer could not be sued for it. A state may no more than an individual principal give its agent authority to commit torts without civil recourse. *Larson,* 337 U.S. at 694 n. 15, 69 S. Ct. at 1463 n. 15.

Brown is therefore amenable to suit in her individual capacity for the claimed copyright violation.

B

That leads to the question whether, as the district court ruled, Brown is nevertheless immune to such an action by virtue of discretionary function immunity as conferred by state law.

The answer is simple. Without regard to the exact nature of any such state law of immunity and to whether, if generally applicable, it would apply here, state law cannot provide immunity to persons sued for violating the Copyright Act in the way here alleged. The Supremacy Clause, U.S. Const. art. VI cl. 2, precludes any such application of state immunity law. While the Constitution does not give Congress exclusive authority over copyright to the exclusion of any state laws, *Goldstein v. California*,

412 U.S. 546, 553, 93 S. Ct. 2303, 2308, 37 L.Ed.2d 163 (1973), the states cannot either enhance or diminish the scope of protection afforded to those categories of writings that "Congress determines . . . worthy of national protection." *Id.* at 559, 93 S. Ct. at 2311. *See also* 17 U.S.C. § 301. Because the materials here in issue fall within the "national protection" provided by the Copyright Act, any immunity provided by state law for violators of rights in those materials would obviously diminish the scope of the Act's protection.

State law therefore provides no immunity to Brown against a claim in her individual capacity, though she may obviously invoke any of the numerous defenses that may be available to her under the Act itself.

We therefore reverse the district court's ruling that Brown is immune under state law to the claim against her in her individual capacity, and remand that claim for further proceedings.

AFFIRMED IN PART; REVERSED AND REMANDED IN PART FOR FURTHER PROCEEDINGS.

TERRENCE WILLIAM BOYLE, District Judge, concurring in part and dissenting in part:

I agree with the majority that the Commonwealth of Virginia has not "constructively consented" and "impliedly waived" its immunity and therefore concur in section IIB of the opinion. I also agree with the majority that the plaintiff's copyright claims against the defendant Brown are enforceable and therefore I concur in section III of the majority opinion.

The majority has concluded that Congress has not expressly abrogated, in clear and unequivocal terms, state immunity under the eleventh amendment for copyright actions brought by private individuals. Because I believe that Congress, through the enactment of the

Copyright Act, 17 U.S.C. §§ 101-914, has abrogated Radford University's eleventh amendment immunity, I respectfully dissent from section IIA of the majority opinion.

The majority points out that eleventh amendment jurisprudence presently interprets that amendment to embody a general principle of sovereign immunity. The rule of *Atascadero State Hospital v. Scanlon*, 473 U.S. 234, 105 S. Ct. 3142, 87 L.Ed.2d 171 (1985), and *Welch v. State Department of Highways*, __ U.S. __, 107 S. Ct. 2941, 97 L.Ed.2d 389 (1987), holds that in order to displace this immunity Congress must do so in "unmistakably clear language." A review of the evolution and language of the Copyright Act leads me to the conclusion that the Act is sufficiently clear and unmistakable to

indicate congressional intent to subject state governments to suits of this nature.

I.

Preliminarily I note that the majority has declined to discuss the methods by which Congress may exercise its power to abrogate state immunity. The district court in this action concluded that Congress may only abrogate the states' eleventh amendment immunity when acting pursuant to § 5 of the fourteenth amendment. *Richard Anderson Photography v. Radford University*, 633 F. Supp. 1154, 1158 (W.D. Va.1986). The Supreme Court has expressly declined to

address this question.[1/] Recent circuit authority concludes that Congress may abrogate when acting pursuant to any plenary power it has been granted by the Constitution. *United States v. Union Gas*, 832 F.2d 1343, 1351-53 (3rd Cir.1987);

1/ Justice Powell, in *Atascadero*, ruled that Congress can abrogate when acting pursuant to § 5 of the fourteenth amendment. 105 S. Ct. at 3145. The district court below construed this language to implicitly negate any other method of abrogation. This implication is unwarranted. Although the Court in *Welch* was not faced with this question because, like the majority here, it did not find a clear and unequivocal expression by Congress to subject the states to suit, the Court did state: "We assume, without deciding or intimidating a view of the question, that the authority of Congress to subject unconsenting States to suit in federal court is not confined to § 5 of the Fourteenth Amendment." 107 S. Ct. at 2946.

McVey Trucking v. Secretary of State, 812 F.2d 311, 316 (7th Cir.1987). This conclusion is consistent with the constitutional balance of power struck between the national government and the individual states.

Article I, § 8, cl. 8 of the Constitution provides: "The Congress shall have *Power* . . .; To promote the Progress of Science and useful Arts, by *securing* for limited Times to Authors and Inventors the *exclusive* Right to their respective Writings and Discoveries." (emphasis added).

Article VI, cl. 2 of the Constitution provides: "This Constitution, and the Laws of the United States which shall be made in Pursuance thereof; . . . shall be the supreme Law of the Land; and the Judges in every State shall be bound

thereby, any Thing in the Constitution or Laws of any State to the Contrary notwithstanding."

The tenth amendment to the Constitution provides: "The powers *not delegated* to the United States by the Constitution, *nor prohibited* by it to the States, *are reserved* to the States respectively, or to the people." (emphasis added).

The plain language of the Constitution delegates to Congress the power to enact exclusive copyright laws. This is exactly what Congress has done.[2/] This

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2/ As the majority explains, these exclusive copyright laws are also the exclusive province of the federal courts. Section 301 of the Act preempts all copyright action based upon the common law or statutes of a state. Furthermore, 28 U.S.C. § 1338(a) provides for

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is a "power" as defined by article I, § 8. It is the kind of "power" which was "delegated" to Congress by the Constitution. Such laws are made supreme law of the land by article VI. It was one of the powers *not* reserved to the states but expressly delegated by the people and the states to the United States in article I and acknowledged in the tenth amendment.

The supremacy clause requires that the judges in every state be bound by this supreme federal law "any Thing in the Constitution or Laws of any State to the Contrary notwithstanding." Certainly something in the Constitution and laws of every state at the time of ratification

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exclusive federal jurisdiction under the Act.

was that state's claim of sovereign immunity. The states were absolutely sovereign and immune from suit when they were at the pinnacle of the political order prior to the Constitution. After the Constitution was ratified, the states shared sovereignty with the United States. The states became servient to the supreme law of the land where power was delegated to the Federal government and exercised by Congress. This construction draws from the plain meaning of the words used in the Constitution.

The eleventh amendment does not arrive on the scene until some ten years after the ratification of the Constitution. The source of the amendment and

its effect is well documented both in history and in law.[3/]

That amendment is remedial in origin, directed as a response to the Court's decision in *Chisholm v. Georgia*, 2 U.S. (2 Dall.) 419, 1 L.Ed. 440 (1793). The amendment has been read expansively by the Supreme Court to address

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3/ *See, e.g.*, J. Orth, The Judicial Power of the United States -- The Eleventh Amendment in American History (1987); Fletcher, *A Historical Interpretation of the Eleventh Amendment: A Narrow Construction of an Affirmative Grant of Jurisdiction Rather than a Prohibition Against Jurisdiction*, 35 Stan.L.Rev. 1033 (1983); Comment, *Copyright Infringement and the Eleventh Amendment: A Doctrine of Unfair Use?* 40 Vand. L.Rev. 225 (1987). *See also Atascadero*, 105 S. Ct. at 3146 n. 2; *Welch*, 107 S. Ct. at 2949-57 & accompanying notes.

circumstances broader than its initial remedial purpose.

A narrow reading of the eleventh amendment would imply that its sole purpose is to withdraw an item of diverse citizenship subject matter jurisdiction from the federal courts. The corollary to such a narrow reading is the conclusion that non-diverse claims which have an independent basis of subject matter jurisdiction in federal court would be allowed against the states. In fact, the Court has concluded that states may not be sued by diverse citizens on *any* ground, not just on the basis of their

status in diversity. *See Welch,* 107 S. Ct. at 2945.[4/]

In *Hans v. Louisiana*, 134 U.S. 1, 10 S. Ct. 504, 33 L.Ed.2d 842 (1890), the Court for the first time held that implicit in the eleventh amendment prohibition against suits by foreign citizens was a recognition that domestic citizens were barred from suing their own

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4/ This holding by the Supreme Court lays the groundwork for prospective conflicts in the enforcement of the law where abrogation of state sovereign immunity is found to exist, regardless of whether it is under section 5 of the fourteenth amendment or under the assumptions concerning abrogation set out in *Welch*. This conflict would arise from the argument that citizens of a state had enforceable rights against their own state but that suits by foreign citizens would continue to be barred by the subject matter jurisdiction bar of the eleventh amendment.

states because of the inherent immunity of the state from such suit.

The Court determined that the eleventh amendment not only deprived the federal courts of subject matter jurisdiction in suits between states and foreign citizens as the amendment expressly states, but also that the principle of sovereign immunity was implied in the amendment against all suits by citizens against states. Taking the broadest possible reading of the language in *Hans*, however, it would be impossible to conclude that the eleventh amendment usurped the delicate balances of power embodied in the Constitution.

The words of the eleventh amendment do not touch upon the issue of sovereign immunity. The amendment limits the subject matter jurisdiction of the

federal courts as it was originally constructed in article III and affirmed in *Chisholm v. Georgia* by removing from article III, § 2 a certain class of cases involving states and other citizens not of that state. The amendment operates on the "judicial power of the United States" and does not by its terms operate on the states. The amendment does not vest states with any new rights; it simply further diminishes the "judicial power" that can be exercised against states by the federal courts.

The federal courts are courts of limited subject matter jurisdiction and thus may not act in those circumstances where they lack subject matter jurisdiction. As such, the concept of sovereign immunity does not germinate from the actual language of the eleventh amendment.

The principle of sovereign immunity that arises from judicial interpretation of the eleventh amendment must by its nature be somewhat less powerful than the sovereign immunity the states originally gave up when they ratified the Constitution. Indeed, the Supreme Court has recognized this fact by explicitly allowing Congress to abrogate state sovereign immunity through § 5 of the fourteenth amendment. It would not be said, however, that the fourteenth amendment has "repealed" the eleventh amendment. Similarly, the eleventh amendment cannot be construed so as to "repeal" article I.

"Extending the eleventh amendment to prohibit congressional power to abrogate under Article I would ignore the states' representation in Congress and their

consent to diminished power implicit in their acceptance of the Constitution." *Union Gas*, 832 F.2d at 1355. Hence, what the Supreme Court has given the states through interpretations of the eleventh amendment is circumscribed by the states' acceptance of the principle of federalism embodied in the Constitution. The sovereign immunity of the eleventh amendment forms a presumption that the states may not be sued. This presumption may be refuted by acts of Congress. In my view then, the Copyright Act, enacted by Congress pursuant to an article I power, may provide the vehicle with which to abrogate the states' immunity.

II

I will now analyze the Act itself with the caveat that I agree with the

majority's conclusion that the statute as a whole must be analyzed in order to gauge congressional intent to abrogate or preserve state eleventh amendment immunity.

The majority relies upon both *Atascadero* and *Welch* to find the language in the Copyright Act insufficient to abrogate state immunity. In *Atascadero*, the Court held that Congress did not abrogate California's eleventh amendment immunity when it passed the Rehabilitation Act of 1973 (29 U.S.C. § 794). Section 794a(a)(2) of the Act allows "any person aggrieved by any act or failure to act by any recipient of Federal assistance or Federal provider of such assistance. . . ." The Court found this general authorization for suit was not the "unmistakably clear language" needed to abrogate. In *Welch*, the Court held

that Texas' immunity was not abrogated by the Jones Act. The Jones Act allows "any seaman who shall suffer personal injury in the course of his employment" to maintain an action (46 U.S.C. § 688). This general authorization was also insufficient to subject the states to suit.

Given this authority, I agree with the majority that the Copyright Act's authorization of suit against "anyone" in § 501 is not *in itself* a sufficiently clear congressional statement to abrogate state immunity under the eleventh amendment. The use of the term "anyone," however, is only a portion of the story.

Section 101 of the original Copyright Act of 1909 made liable "*any person*" who violated the substantive provisions of the Act. An important change was made to

the Act in 1976. Section 501 was drafted to replace former § 101 and made "*anyone*" who violated the Act liable. This change is significant and there is no question that the *change* itself enlarged, rather than contracted or left alone, the class of possible defendants. The court in *Johnson v. University of Virginia*, 606 F. Supp. 321, 324 (D. Va. 1985), was quick to point this out and concluded that the change was expansive enough to encompass the states.[5/]

5/ The *Johnson* court laid the foundation for this conclusion by citing with approval the opinion in *Mills Music, Inc. v. Arizona*, 591 F.2d 1278 (9th Cir. 1979). The *Mills* court found that the "any person" language of the 1909 Act was sufficient to include the states in the class of potential defendants and that Congress, through the Copyright

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The majority fails to mention the change in statutory language. The fact that Congress arrived at the term "anyone" after starting with "any person" indicates it was not satisfied with previous coverage under the Act. A perusal of other statutes indicates that a logical interpretation of the change was that it was designed to include states within the class of potential violators. There is no other conceivable class of potential defendants that could have been intended to be included by the change.

Even at this point in the analysis the language at bar is more demonstrative

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Act, had abrogated the states' eleventh amendment immunity.

in its intent to include the states than that at issue in either *Atascadero* or *Welch*. The generalized language in *Atascadero* is not supported by any similar change in the wording of the statute. The operative language in *Welch* is even less conclusive in identifying the states as possible defendants because it refers to a class of *plaintiffs*. Here the "anyone" language of the Copyright Act refers to a class of defendants.

It is clear that *Atascadero* and *Welch* require unequivocal statutory language in order to abrogate eleventh amendment immunity. The specific language addressed in those cases, however, is far different than that of the Copyright Act. The change from "any person" to "anyone" is indicative of congressional intent to subject the states to suit.

The *change*, standing alone, however, is not a sufficient statement of congressional intent to abrogate state immunity. At a minimum, the term "anyone" certainly does, on its face, include the states within a class of potential defendants.[6/] It is the series of exemptions within the Act that present the necessary "unequivocal indication of congressional intent to subject unconsenting states to suits for money damages in federal court."

6/ Judge Kiser's district court opinion in this case found that "anyone" was a term that included the states. Although Kiser did not undertake an abrogation analysis because he found that article I did not give Congress the power to abrogate, his implied waiver analysis concluded that the states were included in the class of defendants. *Anderson*, 633 F. Supp. at 1159.

III

While § 501, in conjunction with § 504, makes anyone who violates an owner's copyright protections liable for damages, the Copyright Act contains a variety of exemptions from liability. I accept the proposition that when Congress specifically identified states in the exemptions, it intended the states to be subject to suit in all other cases. This interpretation is consistent with the use of the word "anyone" in § 501 where Congress made the field of possible defendants as wide as possible. Then, through a specific list of exemptions, Congress narrowed the field of defendants in order to effectuate the full purposes and policies of copyright law.

It would be a strained statutory construction to hold that Congress added

exemptions to the Copyright Act specifically in favor of the states if the states were already immune under the eleventh amendment.

A. *The Section 602 Exemption*

Section 602 of the Act, in conjunction with § 106 and § 501, prohibits the importation of copies or phonorecords of copyrighted material that have been acquired outside the United States. The prohibition, however, does not apply to "importation of copies or phonorecords under the authority or for the use of the Government of the United States or *of any State or political subdivision of a State*. . . ." (emphasis added).

The majority writes that this language might support Anderson's argument if it read importation "by" any state rather than "under the authority or

for the use of . . . any State." The majority then concludes that the exemption "can most logically, certainly arguably, be read as exempting from liability *only* those private persons or public officials acting in their individual capacity who import copyright materials under governmental authority or for governmental use." *ante* at 120 (emphasis added). This restrictive interpretation, however, produces an anomalous result; state governments are immune under the eleventh amendment, state officials are immune under § 602, local governments are not immune at all, and local officials are immune under § 602. This crazyquilt of liability and immunity cannot be what Congress intended.

A more logical and natural interpretation of § 602 is that it exempts

federal, state and local governments and their officials acting in their official capacity. Officials acting in their official capacity are exempted by the language reading "under the authority . . . of . . ." in § 602(a)(1). The governments, federal, state and local, are exempted by the language reading "for the use of. . . " This language is connected by the word "or" which means that each portion may stand alone. The majority's argument would be more compelling if the connecting word had been "and" but this is not the case. The use of the word "or" indicates an exemption for two distinct "classes" of defendants.

To construe § 602 to provide protection for officials in their individual capacity is inconsistent with the purpose of § 602 which is to prevent importation

of unauthorized and "piratical" materials. The legislative history is barren of support for the idea that *only* government officials in their *individual* capacity are entitled to the protection of the exemption. At a minimum, some inkling in the legislative history would be necessary to sustain the odd interpretation of § 602 the majority has offered. The legislative history of § 602, however, does not speak to the way in which the exemption in (a)(1) should be construed. Thus, the words in the section should be given their plain meaning. In my opinion it is improper to narrow the scope of § 602(a)(1)'s exemption in light of the statutory language and legislative history. By exempting the states in § 602, Congress evidenced a clear and

unequivocal intent to subject the states to suit in non-exempted areas.

B. *The "Governmental Bodies" Exemptions*

The legislative history of § 602 does uncover a point that is relevant in a discussion of other exemptions. In paraphrasing the statutory language of exemption (a)(1), the House Report states that the subsection does not apply to "importation under the authority or for the use of a *governmental body*. . . ." H.R. Rep. No. 1467, 94th Cong., 2d Sess. 167, *reprinted in* 1976 U.S. Code Cong. & Admin. News 5659, 5783, 5785-86 (emphasis added). This is a paraphrase of § 602 that exempts "the Government of the United States or of any State or political subdivision of a State. . . ." This language is relevant to the central

theme of the majority's disposal of the Act's exemptions for "governmental bodies." The majority states that the "phrase 'governmental bodies' in this context has the same ambiguity for the purpose at hand as do the provisions in §§ 107-108." *ante* at p. 119. This conclusion cannot withstand scrutiny. A natural reading of the term "governmental bodies" would include a state government. This conclusion is buttressed by the legislative history of § 602 which uses the phrases "governmental bodies" and "Government of . . . any State" interchangeably. 7/

7/ The legislative history of § 110 does not define the term "government body." Nevertheless, it would be strange indeed if the meaning of the (Continued)

Section 110 of the Act lists a variety of exemptions to the exclusive rights of the copyright holder. Subsection (2) allows performance or display of a nondramatic literary or musical work if:

(A) the performance or display is a regular part of the systematic instructional activities of a *government body* or a nonprofit educational institution; and

(B) the performance or display is directly related and of material assistance to the teaching content of the transmission; and

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phrase varied from section to section within the Act.

(C) the transmission is made primarily for --

(i) reception in classrooms or similar places normally devoted to instruction, or

(ii) reception by persons to whom the transmission is directed because their disabilities or other special circumstances prevent their attendance in classrooms or similar places normally devoted to instruction, or

(iii) reception by officers or employees of governmental bodies as a part of their official duties or employment;

(emphasis added). The majority concludes that the reference to "governmental bodies" in § 110(2) "could be read as applicable *only* to local governments or to actions by government officials so that the states' continued immunity would not render § 110(2) superfluous." *ante* at 119. Again, there is no apparent reason to read the statute in such a restrictive manner. The phrase "governmental bodies" on its face encompasses federal, state and local governments. The majority looks in vain for a definition of the phrase that includes "states" within its grasp. The cart, however, is before the horse. Unless defined otherwise, a phrase should be given its plain meaning.

In subsection (iii) of § 110(2), Congress has demonstrated the ability to

specifically identify "officers or employees of governmental bodies." An interpretation of the term "governmental bodies" to mean *only* government officials is unwarranted given Congress's skills.

Section 110(6) of the Act exempts a:

> (6) performance of a nondramatic musical work by a *governmental body* or a nonprofit agricultural or horticultural fair or exhibition conducted by such body or organization; the exemption provided in this clause shall extend to any liability for copyright infringement that would otherwise be imposed on such body or organization, under doctrines of vicarious liability or related infringement, for a

> performance by a concessionaire, business establishment, or other person at such fair or exhibition, but shall not excuse any such person from liability for the performance;

(emphasis added). This exemption provision goes into great detail to explain that the governmental body itself is the only exempted party. There is no possible construction that would extend the exemption to persons responsible for the performance.

Section 110(6) has been drafted in a specific and detailed fashion. If Congress had intended that local governments were to be the only beneficiary of the exemption, it could easily have so stated. It seems apparent, however, that

all fairs, including state fairs, were targets of this legislation.

The list of exemptions involving "governmental bodies" continues. Section 110(8) exempts transmissions of material to blind or handicapped persons if the transmission is made through the facilities of a governmental body. Section 111(a)(4) permits secondary transmissions by governmental bodies if made for no commercial advantage. Sections 112(b), (c), (d) allow governmental bodies to make copies of limited numbers of phonorecords in certain noncommercial situations. Section 118(d)(3) allows governmental bodies to record certain

transmissions and hold them for a period of seven days.[8/]

8/ Anderson also offers the exemptions contained in §§ 107, 108 and 601. I find Anderson's arguments based on these sections to be less compelling than those based on the aforementioned sections and therefore I will not prolong this dissent any more than is necessary. I do note that §§ 107-108, applying to fair use, libraries and archieves does offer minimal support for Anderson's argument because the coverage therein does cover state activities.

The provisions of § 601, which expired on July 1, 1986, however, are not helpful to the exemption portion of Anderson's argument. Section 601 minimizes copyright protection for works not manufactured in the United States or Canada. Section 601(b)(3) grants the "Government of any State" an exemption from subsection (a) , and, accordingly, the state as a *plaintiff* is entitled to full protection. Section 601, then, does not identify a state as an exempted defendant.

In short, to make all the foregoing exemption provisions applicable only to local governments is to render nugatory a great volume of work done by Congress. It is difficult to believe that the great variety of "governmental body" exemptions found in the Act were prompted by concerns to protect local governments from infringement actions.[9/]

9/ I note in passing that Congress is adept at recognizing state immunity under the eleventh amendment. Several environmental statutes provide for governmental instrumentality or agency liability "to the extent permitted by the eleventh amendment to the Constitution . . .". *See, e.g.*, 33 U.S.C. § 1365(a); 16 U.S.C. § 1540(g)(1)(A); 49 U.S.C. § 1686(a); 42 U.S.C. § 4911(a)(1).

IV

The *Atascadero/Welch* rule requires that Congress express its intent to abrogate in clear and unequivocal terms. Further, the Supreme Court does not permit abrogation to occur on the basis of a general authorization for suit. I believe that the authorization here has been expressed in a more than adequately clear and specific fashion. The change in statutory language coupled with the extensive series of specific exemptions demonstrates congressional intent in this field.

The outcomes of *Atascadero* and *Welch* should not control the present action. The statutory language of the Act in conjunction with the legislative history indicate an unequivocal intent to abrogate the states' immunity under the

eleventh amendment. If Congress had the benefit of *Atascadero* and *Welch* in 1976 when it rewrote the Act, it may be that it would not have taken for granted what appears to be so obvious -- that is that the states may be held accountable for their violations of copyright as secured under the Constitution. Nevertheless, the statute, taken as a whole, demonstrates the necessary specific and unmistakable language needed to abrogate eleventh amendment immunity.

I would allow Anderson to maintain his copyright action against the Commonwealth of Virginia and therefore I must respectfully dissent.

633 F. Supp. 1154

RICHARD ANDERSON PHOTOGRAPHY, Plaintiff,

v.

RADFORD UNIVERSITY, et al., Defendants.

Civ. A. No. 85-0373-R.

United States District Court, W.D. Virginia, Roanoke Division.

April 23, 1986

John M. DiJoseph, Arlington, Va., for plaintiff.

Joan W. Murphy, Asst. Atty. Gen., Richmond, Va., for defendants.

MEMORANDUM OPINION

KISER, District Judge.

At issue in this copyright infringement action is whether the Commonwealth of Virginia has waived its Eleventh

Amendment immunity. I hold that it has not.

I. *Facts*

Plaintiff Richard Anderson Photography (Anderson) has brought this copyright infringement action pursuant to the Copyright Act of 1976, 17 U.S.C. § 101, *et seq.*, against Radford University, an educational institution of the Commonwealth of Virginia, the Visitors of Radford University, and Radford's Director of Public Relations and Information, Deborah L. Brown. In 1981, Radford entered into a contract with the North Charles Street Design Organization (NCSDO) of Baltimore, Maryland to produce a student prospectus. NCSDO retained Anderson, pursuant to the terms of the contract with Radford, to take

photographs to be used in the 1982 student prospectus.[1] Plaintiff Anderson completed the work and the student prospectus was published. He subsequently obtained copyrights for the photographs used in this publication.

The Plaintiff alleges that the Defendants have infringed the copyrights in these photographs by using them, without authorization, in publications other than the 1982 student prospectus.[2]

1/ Although I have assumed for the purposes of this Opinion that NCSDO acted as an agent of Radford University, I make no specific finding in this regard.

2/ For example, the Plaintiff alleges that Radford unlawfully used his photographs in a brochurs soliciting funds for the Radford Athletic Association and in a publication entitled "Radford Sports." The

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In the inital complaint, Anderson sought injunctive relief as well as damages. Since Anderson filed the complaint, however, Radford has returned the photographs to Anderson's possession, and Anderson has dropped his request for injunctive relief.

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brochure was published approximately in August, 1983. The Plaintiff did not register his copyrights in the photographs until September 12, 1983. Section 412(2) of the Copyright Act, however, provides copyright owners with a three-month grace period in which to register their copyrights. Therefore, the Plaintiff has alleged a compensable copyright infringement claim at least as to publication of the Radford Athletic Association brochure. I shall not at this time, however, rule on Defendants' motion for summary judgment alleging that *all* of their purported infringements took place prior to the registration of the photographs.

The Defendants have filed a motion to dismiss based on the Eleventh Amendment of the United States Constitution alleging that they were immune from liability in suits seeking damages.

II. *Discussion*

The Eleventh Amendment affords immunity to the States from suits brought against them in federal court.[3/] In particular, the Eleventh Amendment bars suits in federal court by private parties seeking to impose a liability which must be paid from public funds out of the

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3/ The Eleventh Amendment provides that "[t]he Judicial power of the United States shall not be construed to extend to any suit in law or equity, commenced or prosecuted against one of the United States by Citizens of another state, or by Citizens or Subjects of any Foreign State."

state treasury. *Edelman v. Jordan*, 415 U.S. 651, 663, 94 S.Ct. 1347, 1355, 39 L.Ed.2d 662 (1974). The immunity States and their officers enjoy from suit in federal court is not absolute, however. For example, the Eleventh Amendment does not bar prospective injunctive relief in federal courts against state officials. *Ex Parte Young*, 209 U.S. 123, 28 S.Ct. 441, 52 L.Ed. 714 (1908).[4/]

The Eleventh Amendment also does not bar suits against the States when a State has waived its Eleventh Amendment immunity, or if Congress, acting pursuant to Section Five of the Fourteenth Amendment,

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4/ Because the Plaintiff in this case seeks no injunctive relief, the doctrine of *Ex Parte Young* is inapplicable.

has abrogated the States' Eleventh Amendment immunity, which may be done without the States' consent. *Atascadero State Hospital v. Scanlon*, ___ U.S. ___, 105 S.Ct. 3142, 3145, 87 L.Ed.2d 171 (1985). Congress has the power to "abrogate" the States' Eleventh Amendment immunity without their consent because the Fourteenth Amendment is an inherent limitation on the States' power. *See, Fitzpatrick v. Bitzer*, 427 U.S. 445, 456, 96 S.Ct. 2666, 2671, 49 L.Ed.2d 614 (1976). For Congress to do so, however, it must make its intention "unmistakably clear in the language of the statute." *Atascadero*, 105 S.Ct. at 3147 (Congress' prohibition in the Rehabilitation Act of 1973 against discrimination against the handicapped by "any recipient[s]" of federal financial assistance did not

abrogate the States' Eleventh Amendment immunity). *See also, Quern v. Jordan*, 440 U.S. 332, 99 S.Ct. 1139, 59 L.Ed.2d 358 (1979) (Congress did not abrogate the States' Eleventh Amendment immunity when it enacted 42 U.S.C. § 1983; *Fitzpatrick v. Bitzer* 427 U.S. 445, 96 S.Ct. 2666, 49 L.Ed.2d 614 (1976) (Title VII of the Civil Rights Act of 1964 abrogates the States' Eleventh Amendment immunity).

A State may effect a "waiver" of its Eleventh Amendment immunity either expressly or impliedly. Each situation requires "an unequivocal indication that the State intends to consent to federal jurisdiction that otherwise would be barred by the Eleventh Amendment." *Atascadero*, 105 S.Ct. at 3145 n. 1. As the Supreme Court reasserted in *Atascadero*, "[c]onstructive consent is

not a doctrine commonly associated with the surrender of constitutional rights." *Id., quoting Edelman v. Jordan*, 415 U.S. 651, 673, 94 S. Ct. 1347, 1360, 39 L. Ed.2d 662 (1974).

A State may, for example, expressly waive its constitutional immunity by a state statute or constitutional provision. *Atascadero*, 105 S.Ct. at 3145 n. 1, 3147 (state constitutional provision providing that "[s]uits may be brought against the State in such manner and in such courts as shall be directed by law" did not specifically indicate the States' willingness to be sued in federal court).

Under limited circumstances, a State may also impliedly waive or "consent" to suit in federal court. *Compare Parden v. Terminal Railway Co.*, 377 U.S. 184, 84 S.Ct. 1207, 12 L.Ed.2d 233 (1964) (by

operating a railroad in interstate commerce, Alabama consented to suit in federal court under the Federal Employers' Liability Act, 45 U.S.C. §§ 51-60) *with Atascadero* (by accepting federal funds under the Rehabilitation Act of 1973, 29 U.S.C. § 701, *et seq.*, and by participating in programs funded under the statute, California did not consent to suit in federal court)[5/] *and Edelman*

5/ The Rehabilitation Act of 1973 was passed pursuant to Congress' powers under section five of the Fourteenth Amendment. *Atascadero*, 105 S. Ct. 3149 n. 4, 3150. The Act is thus subject most appropriately to an "abrogation" analysis. The Court of Appeals in *Atascadero*, by focusing on whether California had impliedly waived (or "consented") to federal jurisdiction, incorrectly suggested that the Rehabilitation Act was passed pursuant to the Spending Clause of the United States Consti-

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v. Jordan, 415 U.S. 651, 94 S. Ct. 1347, 39 L.Ed.2d 662 (1947) (by participating in a matching funds program under the Social Security Act, 42 U.S.C. §§ 1381-85, Illinois did not waive its Eleventh Amendment immunity) *and Employees v. Missouri Public Health Department*, 411 U.S. 279, 93 S. Ct. 1614, 36 L.Ed.2d 251 (1973) [by engaging in the operation of hospitals and schools, Missouri did not consent to private suits in federal court under § 16(b) of the Fair Labor

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tution, Art. I, § 8, cl. 1. *Atascadero*, 105 S. Ct. at 3149 n. 5. The Supreme Court held that Eleventh Amendment immunity was inappropriate under either analysis. *Atascadero*, 105 S. Ct. at 3150.

Standards Act of 1938, 29 U.S.C. § 216(b)].[6/]

Whether a State has impliedly waived its Eleventh Amendment immunity requires an additional determination to that of whether the State has "unequivocally indicated" its consent to suit in federal court. A court must also determine, as a threshold matter, whether Congress has authorized suits against "a class of

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6/ A State's consent must not be illusory. As Justice Marshall stated in his concurrence in *Employees*, "[t]o suggest that the State had the choice of either ceasing operation of these vital public services or 'consenting' to federal suit suffices, I believe, to demonstrate that the State had no true choice at all and thereby that the State did not voluntarily consent to the exercise of federal jurisdiction in this case." 411 U.S. at 296.

defendants which literally includes States." *Edelman*, 415 U.S. at 672, 94 S. Ct. at 1360.[7/] *Compare Edelman* (in this Social Security Act case, "the threshold fact of congressional authorization to sue a class of defendants which literally includes States is wholly absent") *with Parden* (when Congress enacted the Federal Employers' Liability Act, it "conditioned the right to operate

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7/ It seems to me that this determination serves two purposes. First, whether Congress created a private cause of action and second, whether Congress created jurisdiction in the Federal Courts to hear the cases as to a class of defendants which includes the States. Obviously, a State by its unilateral waiver of its Eleventh Amendment immunity can neither create a cause of action nor confer jurisdiction in the Federal Courts.

a railroad in interstate commerce upon amenability to suit in federal court").

The Plaintiff in this case seeks relief under the Copyright Act of 1976, an act of Congress passed pursuant to the Copyright and Patent Clause of the United States Constitution, Art. I, § 8, cl. 8.[8/] Congress does not have the power to abrogate the States' Eleventh Amendment immunity without their consent unless it acts pursuant to § 5 of the Fourteenth Amendment. *Atascadero*, 105 S.Ct. at 3145, *citing Fitzpatrick v.*

8/ Under the Constitution's Copyright and Patent Clause, Congress has the power "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." Art.I, § 8, Cl. 8.

Bitzer, 427 U.S. 445, 456, 96 S. Ct. 2666, 2671, 49 L.Ed.2d 614 (1976). Therefore, in my view, the issue in this case turns not on whether Congress has abrogated the States' immunity, but on whether Virginia has waived it. Because there is no evidence that Virginia has expressly waived its Eleventh Amendment immunity, I shall address the question of implied waiver or consent.[9/]

9/ I disagree with the Plaintiff's suggestion that this is an "abrogation" case, not a "waiver" case. The Plaintiff argues that the States have no sovereignty, and thus no immunity, when Congress acts pursuant to one of Article I's enumerated powers, such as the Copyright and Patent Clause. In support of his argument, he cites *Mills Music, Inc. v. Arizona*, 591 F.2d 1278, 1285 (9th Cir. 1979) ("it is clear that the abrogation of a state's Eleventh Amendment immunity is inherent in

(Continued)

As a preliminary matter, I hold that

(Continued)
the Copyright and Patent Clause and the Copyright Act"), and *Goldstein v. California*, 412 U.S. 546, 560, 93 S. Ct. 2303, 2312, 37 L.Ed.2d 163 (1973) ("when Congress grants an exclusive right or monopoly, its effects are pervasive; no citizen or State may escape its reach"). In my view, *Atascadero* and *Edelman* hold that Congress does not have the power to abrogate the States' Eleventh Amendment immunity without their consent unless it acts pursuant to § 5 of the Fourteenth Amendment. Moreover, I believe *Goldstein* is inapposite because it deals not with the issue of Eleventh Amendment immunity, but with the issue of federal preemption of the copyright field (*Goldstein* was decided before the Copyright Act of 1976 made it clear that the federal copyright law preempted state law, 17 U.S.C. § 301.) At issue in *Goldstein* was whether convictions under a California record and tape piracy statute were prohibited by the Copyright and Patent Clause of the United States Constitution. *See supra* note 8. The Supreme Court upheld the convictions and the

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Radford University, a public university, is an "arm of the state" for purposes of the Eleventh Amendment. The Plaintiff admits in his complaint that Radford is an "instrumentality" of the Commonwealth of Virginia, Complaint at 1 (paragraph 4). Moreover, it is quite clear in Virginia that state colleges and universities constitute "arms of the state" for purposes of the Eleventh Amendment. *See, e.g., Jacobs v. College of William and*

(Continued)
validity of the state statute, explaining that "under the Constitution, the States have *not* relinquished all power to grant to authors 'the exclusive Right to their respective Writings'." *Id.* at 560, 93 S. Ct. at 2311 (emphasis added). The Court reasoned that the States may provide copyright owners with additional protections, but may not diminish in any way their federally created rights.

Mary, 495 F. Supp. 183, 189-91 (E.D. Va. 1980), *aff'd.*, 661 F.2d 922 (4th Cir 1981), *cert. denied*, 454 U.S. 1033, 102 S.Ct. 572, 70 L.Ed.2d 477 (1981); *Johnson v. University of Virginia*, 606 F. Supp. 321, 322 (W.D. Va. 1985). Therefore, Radford University enjoys whatever immunity the State enjoys.10/

10/ Whether an institution is an arm of the state depends, in part, upon "the nature of the entity created by state law," *Mt. Healthy City School District Board of Education v. Doyle*, 429 U.S. 274, 280, 97 S.Ct. 568, 572, 50 L.Ed.2d 471 (1977), and upon "whether the entity thus created has power sufficiently distinct and independent from the state as not to be considered merely a part of the state or merely its 'alter ego'." *Jacobs v. College of William and Mary*, 495 F.Supp. 183, 189 (E.D. Va. 1980), *aff'd*, 661 F.2d 922 (4th Cir. 1981), *cert denied*, 454 U.S. 1033, 102 S.Ct. 572, 70 L.Ed.2d 477 (1981). Courts also

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Having determined that Radford University is an "arm of the state" for purposes of the Eleventh amendment, I must now evaluate whether the Commonwealth of Virginia has impliedly waived its constitutional immunity. To do so, I must first determine whether Congress, in enacting the Copyright Act of 1976, 17 U.S.C. § 101, *et seq.*, authorized suits

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look at a number of other factors in determining whether an institution is an "arm of the state." *See, e.g. Jacobs*, 495 F.Supp. at 189; *Herer v. Burns*, 577 F. Supp. 762, 763 (W.D. Va. 1984) (state mental hospital is an arm of the state for purposes of the Eleventh Amendment). One overriding factor under our facts is that any judgment rendered against Radford would be payable from the state treasury because state law provides that all of Radford's real and personal property is the property of the Commonwealth. *Va. Code* § 23-155.3.

against "a class of defendants which literally includes States."

Section 501(a) of the Copyright Act of 1976 provides that "*anyone* who violates any of the exclusive rights of the copyright owner.... is an infringer under the Copyright Act" (emphasis added). The Plaintiff argues that this provision of the Act evinces Congress' intent to include States within the class of defendants against which Congress has authorized suit.

In support of this position, Plaintiff cites two cases: *Johnson v. University of Virginia*, 606 F. Supp. 321 (W.D. Va. 1985) (Michael, J.) (decided under the "anyone" language of the 1976 Copyright Act); and *Mills Music, Inc. v. Arizona*, 591 F.2d 1278 (9th Cir. 1979) (decided under the "any person" language

of the 1909 Copyright Act). In *Mills Music*, the United States Court of Appeals for the Ninth Circuit held that the language of the statute is "sweeping and without apparent limitation, suggesting that Congress intended to include states within the class of defendants." 591 F.2d at 1285. In *Johnson*, Judge Michael relied on *Mills Music* in holding that "the language of the 1976 Act ["anyone"] is at least as sweeping, and probably more sweeping, than the language of the 1909 Act ["any person"] in identifying the class of defendants subject to copyright infringement suits." 606 F.Supp. at 324.[11/]

11/ Although Judge Michael in *Johnson* held that the Eleventh Amendment

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I agree with the Plaintiff that the Copyright Act's general authorization for suits against "anyone" is sufficiently broad to include the States. *See, e.g., Parden v. Terminal Railway*, 377 U.S. 184, 187-88, 84 S. Ct. 1207, 1210-11, 12 L.Ed.2d 233 (1964) (statute providing for liability for "every" common carrier applies to all railroads, whether state owned or privately owned).

On the other than, I cannot find that the Commonwealth of Virginia has waived its Eleventh Amendment immunity because there has been no "unequivocal

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would not bar a damages award, no award was actually made because the alleged infringements took place more than three months before registration. 17 U.S.C. § 412(2). 606 F. Supp. at 324-25.

indication" that Virginia has consented to federal suit. *Atascadero*, 105 S. Ct. at 3145 n. 1. Before a State can be found to have impliedly waived its immunity, its intent to do so must clearly appear from the circumstances. It follows that in making this determination a State must have had a choice to act or not act -- usually this is in the context of accepting or rejecting some benefit that a federal statute or program provides. When an act of Congress authorizes suit against a class of defendants which includes States and when it appears from the context of the federal statute granting the benefit that receipt of the benefit by the State is conditioned upon its surrender of its Eleventh Amendment immunity, the courts will find that the State's actions

constituted a waiver of its immunity. Such was the situation in *Parden* and the Supreme Court held that by choosing to operate a railroad in interstate commerce the state of Alabama had voluntarily subjected itself to the Federal Employers' Liability Act and in so doing had impliedly waived its Eleventh Amendment immunity.

Parden is difficult to reconcile with some of the Court's later cases, such as *Edelman* and *Atascadero* which seem to evidence a greater reluctance on the part of the Court to find an implied waiver.[12/] One possible distinction

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12/ *See also, Welch v. State Department of Highways and Public Transportation*, 780 F.2d 1268 (5th Cir 1986) (en banc), in which the United

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between *Parden* and the later cases is that the operation of a railroad is somewhat less of a traditional function of a State than is the administering of Social Security funds in *Edelman* and the participation in a program for the handicapped in *Atascadero*. Thus, in *Parden*, the Court more readily implied waiver because there was less compulsion for Alabama to choose to operate a railroad than there would have been had it been dealing with a more basic and

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States Court of Appeals for the Fifth Circuit, sitting en banc, held that Texas had not waived its immunity from suit in federal court under the Jones Act, 46 U.S.C. § 688. The Fifth Circuit found that the broad sweep of *Parden* had been limited by later decisions, in particular *Atacadero*.

fundamental function of the State.[13/] The function of the Commonwealth of Virginia in operating Radford University, which per force requires almost daily decision-making with regard to matters

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13/ In *Parden*, the Supreme Court explained that "when a State leaves the sphere that is exclusively its own and enters into activities subject to congressional regulation, it subjects itself to that regulation as fully as if it were a private person or corporation". 377 U.S. at 196, 84 S. Ct. at 1215. This distinction between "governmental and "proprietary" functions, however, has been rejected as unworkable by the Supreme Court in the context of the Tenth Amendment. *Garcia v. San Antonio Metropolitan Transit Authority*, 469 U.S. 528, 105 S. Ct. 1005, 83 L.Ed.2d 1016 (1985). I assume that the distinction is also no longer valid in the context of the Eleventh Amendment. The only point being, the degree of compulsion that a State was under to furnish a particular service or to accept a given benefit is important. *See supra* note 6.

governed by Acts of Congress, including the use of property rights created by the copyright law, is more akin to the choices offered in *Edelman* and *Atacadero* than the choice offered in *Parden*. Consequently, no waiver can be implied.

The Plaintiff argues, however, that Judge Michael's decision in *Johnson v. University of Virginia*, 606 F. Supp. 321 (W.D. Va. 1985), is dispositive of the issue of Eleventh Amendment immunity under the Copyright Act of 1976. In my view, *Johnson* (decided March 27, 1985) would have been decided differently if the court had had available *Atascadero* (decided June 28, 1985) because *Atascadero* imposes a more stringent standard than had been used in the past by requiring courts to find a

"unequivocal indication" of the State's consent to be sued in federal court.[14/]

14/ Besides *Johnson* and *Mills Music*, only three other courts have addressed the issue of the applicability of Eleventh Amendment immunity under the Copyright Act. *Woelffer v. Happy State of America, Inc.*, 626 F. Supp. 499 (N.D. Ill. 1985); *Mihalek Corp. v. Michigan*, 595 F. Supp. 903 (E.D. Mich. 1984), *appeal docketed*, No. 85-1593 (6th Cir. July 23, 1985); *Wihtol v. Crow*, 309 F.2d 777 (8th Cir. 1962). All three of these courts held, in accord with my determination, that Eleventh Amendment immunity was appropriate under the Copyright Act. Insofar as *Wihtol* held that local school districts are "arms of the state" for purposes of the Eleventh Amendment, *Mt. Healthy City School District Board of Education v. Doyle*, 429 U.S. 274, 280-81 (1977), 97 S. Ct. 568, 572-73, 50 L.Ed.2d 471 (school districts are not "arms of the states" unless state law so provides), I agree with the Plaintiff that it may have been incorrectly decided. The Eleventh Amendment applies only to States and agencies and instrumentalities of

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In regard to The Visitors of Radford University, the governing body of the University, *Va. Code* § 23-155.1 and § 23-155.7, it shall enjoy the same immunity as the University.

Whether Radford's Public Relations Director, Deborah Brown, is also entitled

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the State, not to subdivisions such as municipalities and counties. *See Monell v. Department of Social Services*, 436 U.S. 658, 690 n.54, 98 S. Ct. 2018, 2035 n.54, 56 L.Ed.2d 611 (1978) (the Eleventh Amendment is no bar to the liability of cities and other municipalities); *Pennhurst State School and Hospital v. Halderman*, 465 U.S. 89, 123 n.34, 104 S. Ct. 900, 920 n.34, 79 L.Ed.2d 67 (1984) *citing, Lincoln County v. Luning* 133 U.S. 529, 530, 10 S. Ct. 363, 33 L.Ed 766 (1890) (the Eleventh Amendment is no bar to the liability of counties). In light of this, it is understandable when Nimmer states that *Mills Music* is the "better view." 3 M. Nimmer, *Nimmer on Copyright*, § 12.01[E] at 12-21 (1985).

to immunity depends in part upon whether the Commonwealth of Virginia is the "real party in interest" in this action. The Eleventh Amendment prohibits suits against state officials when "the State is the real, substantial party in interest", *Pennhurst State School & Hospital v. Halderman* 465 U.S. 89, 101, 104 S. Ct. 900, 908, 79 L.Ed.2d 67 (1984) *quoting Ford Motor Co. v. Department of Treasury of Indiana*, 323 U.S. 459, 464, 65 S. Ct. 347, 350, 89 L.Ed. 389 (1945), and a State is the real party in interest when "the judgment sought would expend itself on the public treasury or domain, or interfere with the public administration, or if the effect of the judgment would be to restrain the Government from acting, or to compel it to act." *Pennhurst*, 465 U.S. at 101 n.11, 104 S. Ct. at 908 n.11,

quoting Dugan v. Rank, 372 U.S. 609, 620, 83 S. Ct. 999, 1006, 10 L.Ed.2d 15 (1963).

Insofar as this action is directed against Brown in her official capacity, she is immune from liability based on the Eleventh Amendment. Because Brown may be *personally* liable for her alleged misconduct, however, she shall remain a defendant, at least temporarily, as to the copyright infringement claim. I shall refrain from ruling on Brown's motion for summary judgment, therefore, until counsel have had an opportunity to argue whether Brown acted in her individual

capacity, and if so, what defenses may be available to her.[15/]

The Plaintiff has moved to amend his complaint to state a claim against the Commonwealth of Virginia for an unlawful taking of property under the Fourteenth Amendment to the United States Constitution. I shall grant this motion and I invite counsel to submit briefs on the appliability of Eleventh Amendment immunity to this constitutional claim.

15/ For the same reasons, I shall refrain from ruling on the Plaintiff's motion for summary judgment as it relates to Brown in her personal capacity. In addition, I need not rule on Plaintiff's motion for summary judgment as to Defendants Radford, the Board of Visitors, and Brown in her official capacity in light of my Eleventh Amendment ruling.

Constitutional Provisions

U.S. Const. art. 1, § 8, cl. 8

Congress shall have Power ... To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;

U.S. Const. amend. XI

The Judicial power of the United States shall not be construed to extend to any suit in law or equity, commenced or prosecuted against one of the United States by Citizens of another state, or by Citizens or Subjects of any Foreign State.

Provisions of Title 17, U.S.C.

§ 110. Limitations on exclusive rights: Exemption of certain performances and displays

Notwithstanding the provisions of section 106, the following are not infringements of copyright:

(1) performance or display of a work by instructors or pupils in the courts of face-to-face teaching activities of a nonprofit education institution, in a classroom or similar place devoted to instruction, unless, in the case of a motion picture or other audiovisual work, the performance, or the display of individual images, is given by means of a copy that was not lawfully made under this title,

and that the person responsible for the performance knew or had reason to believe was not lawfully made;

(2) performance of a nondramatic literary or musical work or display of a work, by or in the course of a transmission, if --

(A) the performance or display is a regular part of the systematic instructional activities of a governmental body or a nonprofit educational institution; and

(B) the performance or display is directly related and of material assistance to the teaching content of the transmission; and

(C) the transmission is made primarily for --

(i) reception in classrooms or similar places normally devoted to instruction, or

(ii) reception by persons to whom the transmission is directed because their disabilities or other special circumstances prevent their attendance in classrooms or similar places normally devoted to instruction, or

(iii) reception by officers or employees of governmental bodies as a part of their official duties or employment;

(3) performance of a nondramatic literary or musical work or of a

dramatico-musical work of a religious nature, or display of a work, in the course of services at a place or worship or other religious assembly;

(4) performance of a nondramatic literary or musical work otherwise than in a transmission to the public, without any purpose of direct or indirect commercial advantage and without payment of any fee or other compensation for the performance to any of its performers, promoters, or organizers, if --

(A) there is no direct or indirect admission charge; or

(B) the proceeds, after deducting the reasonable costs of producing the performance, are used exclusively for

educational, religious, or charitable purposes and not for private financial gain, except where the copyright owner has served notice of objection to the performance under the following conditions;

(i) the notice shall be in writing and signed by the copyright owner or such owner's duly authorized agent; and

(ii) the notice shall be served on the person responsible for the performance at least seven days before the date of the performance, and shall state the reasons for the objection; and

(iii) the notice shall comply, in form, content, and manner of service, with requirements that the Register of Copyrights shall prescribe by regulation;

(5) communication of a transmission embodying a performance or display of a work by the public reception of the transmission on a single receiving apparatus of a kind commonly used in private homes, unless --

(A) a direct charge is made to see or hear the transmission; or

(B) the transmission thus received is further transmitted to the public;

(6) performance of a nondramatic musical work by a governmental body or a nonprofit agricultural or horticultural organization, in the course of an annual agricultural or horticultural fair or exhibition conducted by such body or organization; the exemption provided by this clause shall extend to any liability for copyright infringement that would otherwise be imposed on such body or organization, under doctrines of vicarious liability or related infringement, for a performance by a concessionnaire, business establishment, or other person at such fair or exhibition, but shall not excuse any such person from liability for the performance;

(7) performance of a nondramatic musical work by a vending establishment open to the public at large without any direct or indirect admission charge, where the sole purpose of the performance is to promote the retail sale of copies or phonorecords of the work, and the performance is not transmitted beyond the place where the establishment is located and is within the immediate area where the sale is occurring;

(8) performance of a nondramatic literary work, by or in the course of a transmission specifically designed for and primarily directed to blind or other handicapped persons who are unable to read normal printed material as a result

of their handicap, or deaf or other handicapped persons who are unable to hear the aural signals accompanying a transmission of visual signals, if the performance is made without any purpose of direct or indirect commercial advantage and its transmission is made through the facilities of: (i) a governmental body; or (ii) a noncommercial educational broadcast station (as defined in section 397 of title 47); or (iii) a radio subcarrier authorization (as defined in 47 CFR 73.293-73.295 and 73.593-73.595); or (iv) a cable system (as defined in section 111(f)).

(9) performance on a single occasion of a dramatic literary work published at least ten years before

the date of the performance, by or in the course of a transmission specifically designed for and primarily directed to blind or other handicapped persons who are unable to read normal printed material as a result of their handicap, if the performance is made without any purpose of direct or indirect commercial advantage and its transmission is made through the facilities of a radio subcarrier authorization referred to in clause (8)(iii); *Provided,* That the provisions of this clause shall not be applicable to more than one performance of the same work by the same performers or under the auspices of the same organization.

Pub.L. 94-553, Title I, § 101, Oct. 19, 1976, 90 Stat. 2549.

§ 110. Limitations on exclusive rights; Exemption of certain performances and displays

(10) notwithstanding paragraph 4 above, the following is not an infringement of copyright; performance of a nondramatic literary or musical work in the course of a social function which is organized and promoted by a nonprofit veterans' organization or a nonprofit fraternal organization to which the general public is not invited, but not including the invitees of the organizations, if the proceeds from the performance, after deducting the reasonable costs of producing the performance, are used exclusively

for charitable purposes and not for financial gain. For purposes of this section the social functions of any college or university fraternity or sorority shall not be included unless the social function is held solely to raise funds for a specific charitable purpose.

(As amended Pub.L. 97-366, § 3, Oct. 25, 1982, 96 Stat. 1759.)

§ 111. Limitations on exclusive rights; Secondary transmissions

(a) **Certain Secondary Transmissions Exempted.**--The secondary transmission of a primary transmission embodying a performance or display of a work is not an infringement of copyright if--

(2) The secondary transmission is made solely for the purpose and under the conditions specified by clause (2) of section 110; . . .

§ 112. Limitations on exclusive rights: Ephemeral recordings

. . . .

(d) Notwithstanding the provisions of section 106, it is not an infringement of copyright for a governmental body or other nonprofit organization entitled to transmit a performance of a work under section 110(8) to make no more than ten copies or phonorecords embodying the performance, or to permit the use of any such copy or phonorecord by any governmental body or nonprofit organization entitled to transmit a performance of a work under section 110(8), if--

(1) any such copy or phonorecord is retained and used solely by the organization that made it, or by a governmental body or nonprofit organization entitled to transmit a

performance of a work under section 110(8), and no further copies or phonorecords are reproduced from it; and

(2) any such copy or phonorecord is used solely for transmissions authorized under section 110(8), or for purposes of archival preservation or security; and

(3) the governmental body or nonprofit organization permitted any use of any such copy or phonorecord by any governmental body or nonprofit organization under this subsection does not make any charge for such use.

Title I, Oct. 19, 1976, 90 Stat. 2558.

§ 118. Scope of exclusive rights: Use of certain works in connection with noncommercial broadcasting

. . . .

(d) Subject to the transitional provisions of subsection (b)(4), and to the terms of any voluntary license agreements that have been negotiated as provided by subsection (b)(2), a public broadcasting entity may, upon compliance with the provisions of this section, including the rates and terms established by the Copyright Royalty Tribunal under subsection (b)(3), engage in the following activities with respect to published nondramatic musical works and published pictorial, graphic, and sculptural works:

. . . .

(3) the making of reproductions by a governmental body or a nonprofit institution of a transmission

program simultaneously with its transmission as specified in clause (1), and the performance or display of the contents of such program under the conditions specified by clause (1) of section 110, but only if the reproductions are used for performances or displays for a period of no more than seven days from the date of the transmission specified in clause (1), and are destroyed before or at the end of such period. No person supplying, in accordance with clause (2), a reproduction of a transmission program to governmental bodies or nonprofit institutions under this clause shall have any liability as a result of failure of such body or institution to destroy such

reproduction: *Provided*, That it shall have notified such body or institution of the requirement for such destruction pursuant to this clause: *And provided further*, That if such body or institution itself fails to destroy such reproduction it shall be deemed to have infringed.

§ 501. Infringement of copyright

(a) Anyone who violates any of the exclusive rights of the copyright owner as provided by sections 106 through 118, or who imports copies or phonorecords into the United States in violation of section 602, is an infringer of the copyright.

(b) The legal or beneficial owner of an exclusive right under a copyright is entitled, subject to the requirements of sections 205(d) and 411, to institute an action for any infringement of that particular right committed while he or she is the owner of it. The court may require such owner to serve written notice of the action with a copy of the complaint upon any person shown, by the records of the Copyright Office or otherwise, to have or claim an interest

in the copyright, and shall require that such notice be served upon any person whose interest is likely to be affected by a decision in the case. The court may require the joinder, and shall permit the intervention, of any person having or claiming an interest in the copyright. . . .

§ 504. Remedies for infringement: Damages and profits

(a) **In General.**--Except as otherwise provided by this title, an infringer of copyright is liable for either--

(1) the copyright owner's actual damages and any additional profits of the infringer, as provided by subsection (c); or

(2) statutory damages, as provided by subsection (c).

§ 602. Infringing importation of copies or phonorecords

(a) Importation into the United States, without the authority of the owner of copyright under this title, of copies or phonorecords of a work that have been acquired outside the United States is an infringement of the exclusive right to distribute copies of phonorecords under section 106, actionable under section 501. This subsection does not apply to--

(1) importation of copies or phonorecords under the authority or for the use of the Government of the United States or of any State or political subdivision of a State, but not including copies or phonorecords for use in schools, or copies of any audiovisual work

imported for purposes other than archival use.

No. 88-651

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Supreme Court, U.S.
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IN THE
Supreme Court of the United States
OCTOBER TERM, 1988

RICHARD ANDERSON PHOTOGRAPHY,
Petitioner,

v.

RADFORD UNIVERSITY, *et al.*,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Fourth Circuit

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RESPONDENTS' BRIEF IN OPPOSITION

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15 pp

QUESTION PRESENTED

Does the Copyright Act of 1976, 17 U.S.C. §§ 101-800, reflect the requisite unmistakable Congressional intent to abrogate the interests of state sovereignty guaranteed by the Eleventh Amendment to the United States Constitution?

LIST OF PARTIES

The petitioner in this Court and the appellant below: Richard Anderson Photography. The respondents in this Court, and appellees below: Radford University and the Board of Visitors of Radford University. Other appellees below, not respondents in this Court: Deborah Brown, Director of Public Information and Relations, Radford University; and Bernice Thieblot and Armand Thieblot, owners of North Charles Street Design Organization.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1988

No. 88-651

RICHARD ANDERSON PHOTOGRAPHY,
Petitioner,

v.

RADFORD UNIVERSITY, *et al.*,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Fourth Circuit

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RESPONDENTS' BRIEF IN OPPOSITION

STATEMENT OF THE CASE

Radford University ("Radford") is a state institution of higher education in Virginia. Virginia Code §§ 23-155.1 through 23-155.10. In 1981, Radford entered into an oral agreement with North Charles Street Design Organization ("NCSDO") to produce certain publications to be used in recruiting students (hereinafter referred to collectively as "recruiting materials"). NCSDO in turn entered into a contract with Richard Anderson Photography ("Anderson") to provide the photographs to be used in the recruiting materials. In October 1981, NCSDO informed Radford, in writing, that all photographic slides prepared by Anderson would be the property of Radford,

and that the negatives would remain the property of Anderson.

Anderson prepared a large number of photographic slides, the vast majority of which were used in connection with the recruiting materials. Some (perhaps as few as one) were used in an athletic promotion brochure. Anderson contested, as unauthorized, this use of the slide or slides.

In April 1985, Anderson filed suit for copyright infringement against Radford, its governing board, and its public information officer Deborah Brown in the United States District Court for the Western District of Virginia. All of Anderson's photographic slides bore a copyright notice, but none were registered at the time of any of the uses made of them by Radford. In May 1985, Radford returned to Anderson all of the photographic slides. Anderson has continued to seek damages for the alleged unauthorized use of the slides.

On April 23, 1986, the district court dismissed Radford, its governing board and Brown in her official capacity on grounds of Eleventh Amendment immunity. (633 F. Supp. 1154.) Anderson appealed to the United States Court of Appeals for the Fourth Circuit.

On July 20, 1988, the Fourth Circuit affirmed the district court's dismissal, holding that Congress had not expressed unequivocally in the statutory language of the Copyright Act the requisite intent to abrogate the states' Eleventh Amendment immunity. (852 F.2d 114.) Nor, the Fourth Circuit held, had Virginia or its institutions constructively waived Eleventh Amendment immunities for purposes of alleged copyright infringement. The Fourth Circuit remanded for further action the district court's dismissal of Deborah Brown in her individual capacity, holding that a state employee was not immune under the Eleventh Amendment for alleged copyright infringement. 852 F.2d at 122-23.

REASONS FOR DENYING THE WRIT

For the reasons which follow, the respondents respectfully submit that this Court should decline the invitation to review the Fourt Circuit's opinion. Rule 17 of the Rules of the United States Supreme Court provides that a writ of certiorari will be granted "only when there are special and important reasons therefor." Of the specific types of such special and important reasons set forth in the rule, only one is at all germane to this case. That criterion, set forth in 17.1.(c), militates in favor of granting a writ when "a federal court of appeals has decided an important question of federal law which has not been, but should be, settled by this Court[.] . . ."

While the specific question that Anderson seeks to have this Court address—*i.e.* the effect of the Eleventh Amendment *vis-à-vis* the Copyright Act—has not been decided by this Court, there is no conflict in the circuits on the issue. Both the Fourth Circuit decision Anderson seeks to have this Court review, and the recent decision of the Ninth Circuit in *B.V. Engineering v. University of California, Los Angeles*,[1] found no sufficient evidence of Congressional intent in the statutory language of the Copyright Act to abrogate the states' immunities.

Nor is the decision of the Fourth Circuit substantively flawed. This Court has clearly delineated the extent and nature of the Eleventh Amendment bar,[2] and lucidly described the scrutiny that must be focused on any federal statute when attempting to find Congressional intent to abrogate the immunity conferred by the amendment.[3]

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[1] 858 F.2d 1394 (9th Cir. 1988), overturning *Mills Music, Inc. v. Arizona*, 591 F.2d 1278 (9th Cir. 1979).

[2] *See, e.g., Papasan v. Allain*, 478 U.S. 265 (1986); *County of Oneida v. Oneida Indian Nation*, 470 U.S. 226 (1985); *Pennhurst State School and Hospital v. Halderman*, 465 U.S. 89 (1984).

[3] *Welch v. State Dept. of Highways and Transportation*, 107 S. Ct. 2941 (1987); *Green v. Mansour*, 474 U.S. 64 (1985); *Atascadero State Hospital v. Scanlon*, 473 U.S. 234 (1985).

The Fourth Circuit's decision in the instant case studiously resorted to, and correctly applied, that precedent.

Anderson also argues that this Court should accept this case on certiorari because the Fourth Circuit's opinion advances no legitimate purpose of the amendment. This argument is not well founded. The interest the amendment advances, which is no less inherent in the facts of this case because it concerns alleged copyright infringement, is the preservation of comity between state and federal governments. This is an interest manifestly as important as the availability of money damages to individuals who have been unable to cite any specific examples of abuse.

Because the Fourth Circuit opinion follows so precisely the clear guidance of this Court's Eleventh Amendment precedent, Anderson seeks to avoid the effect of the application of this law by invoking the doctrine of constructive waiver. In *Welch v. State Department of Highways and Public Transportation*, 107 S. Ct. 2941, 2947-48 (1987), this Court clearly announced the death of that doctrine, if it still had viability, by stating that to the extent *Parden v. Terminal Railway*, 377 U.S. 184 (1964), was inconsistent with *Welch*, *Parden* was overruled. Thus, constructive waiver is simply a dead legal theory. As such it cannot form the basis for the exception Anderson seeks.

Granting a writ of certiorari under these circumstances—where there is no conflict of lower courts to resolve, or flawed application of this Court's precedent in the specific case of which review is sought—implies the necessity for this Court to rule on each and every federal enactment in which an Eleventh Amendment defense is raised. This Court should reject such an expansive reading of its responsibilities, and continue to defer to the circuits to apply its clear jurisprudence, as the Fourth Circuit has done in this case.

Because there is no conflict in the circuits, and no conflict between the Fourth Circuit's opinion and this Court's precedent, Anderson attempts to make much of the alleged importance of the question presented in this case by noting that jurisdiction under the Copyright Act is exclusively in the federal courts. Anderson argues that the Fourth Circuit's opinion effectively forecloses its ability to seek damages against Radford in any forum. This appeal to the equities of the situation is unwarranted for several reasons. First, while damages may not be available against Radford under the Copyright Act, they are available against its agents acting in their individual capacities, and the Fourth Circuit so found. *See* 852 F.2d at 122-23. Second, the unavailability of damages under the Copyright Act does not leave Anderson without remedy.

The laws and Constitution of the Commonwealth of Virginia give clear remedies outside the context of the Copyright Act. The Virginia Constitution states, in Article I, § 11, that "no person shall be deprived of . . . property without due process of law," nor shall the General Assembly pass "any law whereby private property shall be taken or damaged for public uses, without just compensation[.]" This section of the Virginia Constitution is self-executing and authorizes a common law action to recover damages for property taken or damaged by the Commonwealth. *Burns v. Board of Supervisors of Fairfax County*, 218 Va. 625, 627, 238 S.E.2d 823, 825 (1977); *Swift & Co. v. Newport News*, 105 Va. 108, 114-15, 52 S.E. 821, 824 (1906).

In addition to the self-executing constitutional provision referred to above, the Code of Virginia broadly provides a mechanism for the presentation of any "pecuniary claim against the Commonwealth upon any legal ground" to the head of the state entity giving rise to the claim or, if that cannot be determined, the state Comptroller. *See* Virginia Code § 2.1-223.1. If the claim is disallowed,

Virginia Code § 8.01-192 provides "the person presenting such claim may petition an appropriate circuit court for redress." *See also, Stuart v. Smith-Courtney Co.*, 123 Va. 231, 96 S.E. 241 (1918). Moreover, tort claims against the Commonwealth may be brought pursuant to the Virginia Tort Claims Act, Virginia Code §§ 8.01-195.1 through 8.01-195.8. Property which is tortiously taken by government is always compensable under state law.[4]

The issue of the quality of the available remedies is a red herring. Eleventh Amendment jurisprudence does not turn on what the law should be. The Eleventh Amendment requires that Congress unequivocally express its intention where state interests are concerned. If that intention is not unmistakably apparent, the federal law is not applicable to the states. As this Court has emphasized, the states have vital interests that are at stake

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[4] Every state in the Union provides, by constitution or statute, a remedy for unlawful taking of private property by the government. *See, e.g.*, Ind. Const. Art. 1, §§ 12, 21 (Burns 1978); Ky. Const. §§ 13, 231 (Michie/Bobbs-Merrill 1988); La. Const. Art. 1, § 2 (West 1977); Md. Const. §§ 19, 24 (1981); Mass. Const. §§ 19, 24 (West 1981); Mich. Const. Art. 1, § 17; Minn. Const. Art. 1, § 7 (West 1976); N.J. Const. Art. 1, ¶ 1 (West 1971); N.J. Const. Art. 4, § 6, ¶ 3 (West 1971); N.J. Const. Art. 1, § 6 (McKinney 1982); N.C. Const. Art. I, § 19 (1984); Pa. Const. Art. 1, §§ 2, 9, 11 (Purdon 1969); Tex. Const. Art. 1 §§ 17, 19 (Vernon 1984); Ind. Code Ann. §§ 34-4-16.1–34-4-16.7 (Burns Supp. 1988); Ky. Rev. Stat. Ann. §§ 44.070-44.160 (Michie/Bobbs-Merrill 1986); La. Rev. Stat. Ann. § 13:5101 *et seq.* (West Supp. 1988); La. Rev. Stat. Ann. § 49:111 *et seq.* (West 1987); Md. State Gov't Code Ann. §§ 12-101–12-204 (Supp. 1988); Mass. Gen. Laws Ann. ch. 258, § 1 *et seq.* (West 1988); Mass. Gen. Laws Ann. ch. 260, § 3A (West 1959); Mich. Comp. Laws Ann. § 21.12 (West 1981); Mich. Comp. Laws Ann. § 691.1401 *et seq.* (West 1987); N.J. Stat. Ann. §§ 52:4A-1, 52:17B-4.1, 52:17B-4.2 (West 1986); N.J. Stat. Ann. §§ 59:1-1 *et seq.* 59:11-1 (West 1982); N.Y. Jud. Law §§ 8-27 (McKinney Supp. 1988); N.C. Gen. Stat. § 143-291 *et seq.* (1987); 42 Pa. Cons. Stat. Ann. §§ 761, 4651-1 *et seq.*, 8521 *et seq.*, (Purdon Supp. 1988); Tex. Rev. Civ. Stat. Ann. § 6252-19 *et seq.* (Vernon Supp. 1989).

protected by the Eleventh Amendment. In those instances in which it has the power to do so,[5] Congress may override these interests, but must clearly and unequivocally indicate such intention. In this context, the Ninth Circuit's statement in *B.V. Engineering v. University of California, Los Angeles*, 858 F.2d at 1400, that "[i]t is for Congress . . . to remedy this problem[,]" quoted with disfavor in footnote 8 of Anderson's brief, is absolutely correct and proper. If there is a "problem," it is one the legislative process should address.[6]

It is by no means clear, however, that there is a problem. Despite the numerous hypothetical tales of woe that have been paraded by the advocates of Anderson's position throughout this litigation, not one single *actual* instance of the type of abuse by the states that these advocates purport to fear has been cited. Because laws typically address actual needs, it is conceivable that Congress chose not to subject the states and their instrumentalities to the Copyright Act because there is no record of abuse to support such action. Clearly, where Congress perceives a need to make clear its intent, it can do so.

For the foregoing reasons, respondents respectfully submit that this Court should decline this invitation to

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[5] Although the district court addressed the issue of Congressional power to abrogate pursuant to the Patent and Copyright Clause, the Fourth Circuit did not reach that issue, and it is not necessary for this Court to do so to answer the question presented here.

[6] The legislative process is, in fact, currently reviewing the specific question this Court is being asked to decide: whether the states should be subject to federal suits for damages under the Copyright Act. The report of the Register of Copyrights, *Copyright Liability of States and the Eleventh Amendment* (June 1988), referred to at pp. 7, 8, 19 and 33 of Anderson's brief, was specifically prepared for members of the House Subcommittee on Courts, Civil Liberties and the Administration of Justice, of the Committee of the Judiciary, at their request, as part of this review.

forge new Eleventh Amendment jurisprudence and undertake a singularly legislative responsibility.

CONCLUSION

Because the Fourth Circuit's opinion correctly applies this Court's Eleventh Amendment jurisprudence and is not in conflict with any other circuit opinion, and further because the question presented centers on a public policy question which should be addressed by Congress, this Court should deny the petition for writ of certiorari.

Respectfully submitted,

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ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

MOTION FOR LEAVE TO FILE AND BRIEF *AMICI CURIAE* OF THE ASSOCIATION OF AMERICAN PUBLISHERS, INC. AND THE ASSOCIATION OF AMERICAN UNIVERSITY PRESSES, INC. IN SUPPORT OF PETITION FOR CERTIORARI

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MOTION OF THE ASSOCIATION OF AMERICAN PUBLISHERS, INC. AND THE ASSOCIATION OF AMERICAN UNIVERSITY PRESSES, INC. FOR LEAVE TO FILE BRIEF *AMICI CURIAE*

The Association of American Publishers, Inc. ("AAP") and the Association of American University Presses, Inc. ("AAUP") respectfully move for leave to file the attached brief *amici curiae*. The consent of counsel for Petitioner has been obtained, but counsel for Respondents has refused consent.

The AAP is a trade association of book publishers. Its approximately 300 members publish between 70 and 75% of the dollar volume of all books published in the United States. Its members' publications include text, technical and reference books, works of fiction and general nonfiction, together with a variety of works in other media including computer software and databases.

The Association of American University Presses, Inc. is a not-for-profit association of university presses. Its 80 members include the presses of virtually every distinguished university in the United States, as well as several Canadian and international scholarly publishers.

As publishers and copyright proprietors, *amici* have a direct and compelling interest in this case. All depend on competitors' and customers' respect for the property rights guaranteed by §106 of the Copyright Act. Most importantly, all market their copyrighted works to state and state entities. Some AAP and AAUP members derive a substantial portion of their income from state universities such as Respondent Radford University, which has been held in the opinion below to have Eleventh Amendment immunity from liability for damages for copyright infringement. This decision, if not reviewed and reversed, may have greater impact upon *amici* than upon Petitioner, since they rely to such a large extent on state entities for their income.

The Court should grant *certiorari* in order to insure that states and state entities not obtain—demonstrably against congressional intention—a judicial license freely to duplicate, adapt, or publicly perform others' copyrighted works without authorization or any payment of royalties until such time as such infringements may be discovered and an injunction sought and issued.

To present their views as to why this Court should grant *certiorari* in this important copyright case, *amici* move for leave to file the attached brief *amicus curiae.*

Respectfully submitted,

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BRIEF OF *AMICI CURIAE*

INTEREST OF *AMICI CURIAE*

The interest of *amici* is set out in the foregoing motion.

SUMMARY OF ARGUMENT

1. Congress has the power to abrogate states' Eleventh Amendment immunity whenever it enacts legislation under its plenary authority, including the authority found in such diverse provisions of Article I of the Constitution as those covering interstate commerce, copyright, and bankruptcy matters. This Court has never held otherwise. A decision to do so would not only deprive Petitioner of a federal forum for seeking relief from state Respondents in the instant controversy, but also deprive copyright owners of *any* forum in which to seek effective relief for copyright infringement from states and state entities (or compel Congress to provide for copyright actions in state courts, a result wholly at odds with the plenary copyright power granted in Article I).

2. Congress, at the conclusion of a comprehensive process of examination and revision of the copyright law, enacted a statute that by its terms and its structure clearly envisaged states' liability for copyright infringement damages. The judgment below contravenes that clear congressional intent, duly enacted into law.

ARGUMENT

I. ARTICLE I OF THE CONSTITUTION EMPOWERS CONGRESS TO ABROGATE THE STATES' IMMUNITY TO SUITS FOR DAMAGES IN FEDERAL COURTS

In most Eleventh Amendment cases, "the issue is not the general immunity of the States from private suit . . . but merely the susceptibility of the States to suit before *federal tribunals.*" *Atascadero State Hosp. v. Scanlon,* 473 U.S. 234, 240 n.2 (1985) (emphasis in original) (quoting *Employees v. Missouri Dep't of Public Health and Welfare,* 411 U.S. 279, 293-94 (1973) (Marshall, J., concurring in result)). Whenever the Eleventh Amendment has previously been found to preclude federal court jurisdiction, some other forum has been available. *See, e.g., Atascadero,* 473 U.S. at 240 n.2 ("It denigrates the judges who serve on the State courts to suggest that they will not enforce the supreme law of the land"); *Pennhurst State School and Hosp. v. Halderman,* 465 U.S. 89, 121-23 (1984) (requiring pendent state law claims to be brought in state court); *Welch v. State Dep't of Highways,* 107 S.Ct. 2941, 2953 n.19 (1987) (worker's compensation claim could be pursued in state court).

For petitioner and all others holding copyrights, however, Congress long ago decided that to maintain the unity and integrity of copyright law—a worthy goal that Congress is surely empowered to pursue—no relief can be sought in state courts.[1]

For publishers represented by *amici,* as well as others —authors, artists, playwrights, filmmakers, composers, computer programmers, and more—of this country's creative commu-

[1] 28 U.S.C. § 1338(a) (1982). The Copyright Act, by preempting state laws that might otherwise cover copyright infringing activities, 17 U.S.C. § 301 (1982), precludes any possibility that copyright owners might seek relief from state entities on state law grounds in state courts. *Cf. Welch,* 107 S.Ct. 2941, where a state law remedy was potentially available.

nity, therefore, a holding that Congress could not, under its Article I powers, abrogate Eleventh Amendment immunity, would be devastating. AAP and AAUP members, for example, do substantial business with state entities.[2] Indeed, some specialized publishers may do the majority of their business with entities having potential Eleventh Amendment immunity. If the Eleventh Amendment closes the federal courthouse door to them, then states would be free to ignore the carefully crafted balance created by the copyright law, 17 U.S.C. §§ 101 *et. seq.*[3] The availability of actions for damages against state employees in their individual capacities, *Richard Anderson Photography v. Radford University,* 852 F.2d 114, 122, does little to restore that balance. Large-scale infringements may lead to substantial liability,[4] as to which state employees might well be partially or totally judgment-proof.

Until relatively recently, very few copyright cases had involved Eleventh Amendment issues. The only two cases

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[2] AAP estimates that, in 1986, U.S. book publishers sold $1.1 billion worth of college and university textbooks to customers with potential Eleventh Amendment immunity who might well not be liable for damages should they choose to copy rather than purchase such materials. *See generally,* Register of Copyrights, *Copyright Liability of States and the Eleventh Amendment* 5-17 (1988) (hereafter "1988 Register's Report").

[3] While under Eleventh Amendment doctrine some manner of injunctive relief may be available, Congress could not have considered injunctions alone to be an adequate remedy for copyright infringement. By their nature, injunctions can merely "forestall future violations." *United States v. Oregon State Medical Society,* 343 U.S. 326, 333 (1952). Injunctions, unlike damages, do not provide any degree of recompense to aggrieved copyright owners for infringements that have already occurred, or for markets that have been substantially eroded, if not destroyed. Nor are they available without a likelihood of repeated harm by the infringing party. A limitation to injunctive relief would eliminate any real possibility of favorable settlement for copyright owners and would permit the continuation of infringing activity by great numbers of entities, until in each separate case the particular infringement happens to be detected and an injunction obtained.

[4] Congress, recognizing the necessity of providing substantial damages in order to deter infringements and compensate their victims, has recently doubled the monetary limits in the section of the copyright law providing for statutory damages for infringement, 17 U.S.C. § 504. See, 134 Cong. Rec. H10093 (1988).

concerning the Copyright Act of 1909 were split on the Eleventh Amendment question. In *Wihtol v. Crow,* 309 F.2d 777 (8th Cir. 1962), the court held a school system immune from liability for a teacher's infringing duplication of a musical work, while in *Mills Music, Inc. v. Arizona,* 591 F.2d 1278 (9th Cir. 1979), the court held a state liable for the unauthorized public performance of music. In the last several years, however, additional courts have felt themselves constrained to accord Eleventh Amendment immunity in copyright cases,[5] notwithstanding the evident conflict between that result and the clear congressional intention to subject "anyone" infringing copyrights to federal suit.

The Fourth Circuit declined to reach the question whether Congress has the power to subject states to suit in federal court for copyright infringement, holding that even assuming the power existed it had not been properly invoked according to the demanding standards this Court has imposed subsequent to passage of the Copyright Act of 1976. *Richard Anderson Photography,* 852 F.2d 114, 117 (4th Cir. 1988). It is imperative for this Court to reach and settle that question of congressional power. Protection for *amici's* copyrights and their substantial investment in those copyrights depends on their ability to secure either the protection that Congress undoubtedly *intended* to provide in 1976, or additional legislation to the same effect but this time containing the magic words this Court has subsequently held may be necessary to achieve the same result. If Congress presently lacks the power to subject states to copyright infringement actions in federal court, Congress would have to decide whether to jettison its long-standing policy against concurrent jurisdiction over copyright actions in state courts, or to seek adoption of a constitutional amendment

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[5] *BV Engineering v. UCLA,* _____ F.2d _____, 8 U.S.P.Q. 2d 1421 (9th Cir. 1988); *Cardinal Indus. v. Anderson Parrish,* No. 83-1038-Civ-T-13 (M.D. Fla. Sept. 6, 1985), *aff'd* 811 F.2d 609 (11th Cir.), *cert. denied,* 108 S.Ct. 88 (1987); *Woelffer v. Happy States of America, Inc.,* 626 F.Supp. 499 (N.D. Ill. 1985); and *Mihalek Corp. v. Michigan,* 595 F.Supp. 903 (E.D. Mich. 1984), *aff'd on other grounds,* 814 F.2d 290 (6th Cir.), *cert. denied* 108 S.Ct. 503 (1987). *Contra, Johnson v. University of Va.,* 606 F.Supp. 321 (W.D. Va. 1985).

permitting federal court suits against states for copyright infringement. Whatever approach is necessary, time is of the essence. Demonstrably, this case would be an appropriate vehicle to clear away roadblocks to achieving, through any of these routes, the protection Congress both intended and clearly will provide, if necessary.

On the merits of this case, *amici* submit that Congress clearly has the power, under Article I of the Constitution, to abrogate Eleventh Amendment immunity. This court has suggested that such power exists, and, as set out below, several courts of appeals have expressly reached this conclusion. See, e.g., *Green v. Mansour,* 474 U.S. 64, 68 (1985) ("Because of the Eleventh Amendment, States may not be sued in federal court unless they consent to it in unequivocal terms or unless Congress, *pursuant to a valid exercise of power,* unequivocally expresses its intent to abrogate the immunity") (emphasis added); *Welch,* 107 S.Ct. at 2946 (power assumed); *County of Oneida v. Oneida Indian Nation,* 470 U.S. 226, 252-53 (1985) (same), *United States v. Union Gas Co.,* 832 F.2d 1343, 1356 (3d Cir. 1987), *cert. granted, sub. nom. Pennsylvania v. Union Gas Co.,* 108 S. Ct. 219 (1988)[6] (constitutional amendments not to be read as if on a time line; "a constitutional grant of plenary authority to Congress" sufficient to abrogate Eleventh Amendment immunity); *In re McVey Trucking, Inc.,* 812 F.2d 311, 314-23 (7th Cir.), *cert. denied,* 108 S.Ct. 227 (1987) (discussing *Atascadero* and its predecessors, and concluding, after extensive analysis, that the various Congressional plenary powers cannot be distinguished); *In re Vazquez, Guerrero and Compton,* 788 F.2d 130, 132 (3d Cir.), *cert. denied,* 107 S.Ct. 414 (1986) (abrogation of Eleventh Amendment immunity under Bankruptcy Clause); *Mills Music, Inc. v. Arizona,* 591 F.2d 1278, 1285 (9th Cir. 1979), effectively overruled, *BV Engineering v. UCLA,* ____ F.2d ____, 8 U.S.P.Q. 2d 1421 (9th Cir. 1988) ("[T]he Copyright and Patent Clause is a

[6] AAP and AAUP have filed a brief *amici curiae* in *Union Gas* in support of Respondent Union Gas' argument that Congress may abrogate Eleventh Amendment immunity when legislating under the authority of Article I.

specific grant of constitutional power that contains inherent limitations on state sovereignty . . . [A]brogation of a state's Eleventh Amendment immunity is inherent in the Copyright and Patent Clause and the Copyright Act"); *Peel v. Florida Dep't of Transp.*, 600 F.2d 1070, 1080-81 (5th Cir. 1979) (Congress may abrogate state immunity in an act passed pursuant to the war powers in Art. I, § 8). See also *County of Monroe v. Florida*, 678 F.2d 1124, 1132 n.8, 1133 (2d Cir. 1982), *cert. denied*, 459 U.S. 1104 (1983) (Congress may, pursuant to Art. IV, § 2, cl. 2, abrogate state immunity from suit on extradition-related claims).

Recognition of Congress' power to abrogate Eleventh Amendment immunity under Article I is essential if the statutory balance between copyright owners and users of their works is to be maintained. Recent copyright litigation and other claims of Eleventh Amendment immunity in the copyright context[7] reflect assertions that states are substantially beyond the reach of the copyright law. A decision holding Congress unable to abrogate state immunity under its Article I powers could affect the fundamental property rights of *amici* and all copyright owners.

II. IN THE COPYRIGHT ACT CONGRESS EXPRESSED IN UNMISTAKABLE LANGUAGE ITS CLEAR INTENTION TO SUBJECT STATES TO COPYRIGHT LIABILITY

If, as we have argued, Congress has the power to subject Respondent Radford University to liability for copyright infringement in federal court, then the question remains whether

[7] In a recent congressionally requested inquiry, the Copyright Office of the Library of Congress noted that, in addition to the six states asserting Eleventh Amendment copyright immunity in the cases cited in n.5, *supra* (Virginia, California, Florida, Massachusetts, Michigan and Illinois), North Carolina, Wisconsin, Minnesota, and Texas have asserted their immunity in other contexts. 1988 Register's Report at 8, 9, app. C at CRS-21 (1988).

Congress has exercised that power. Under traditional standards, and even under the more demanding standards that this Court has recently announced,[8] the answer to the question here, as recognized by the dissent in the Fourth Circuit[9], is plainly "yes." Because Congress clearly expressed its intent to require states to respect rights granted in the Copyright Act—rights that can be enforced *only* in federal court—the conclusion is inescapable that Congress successfully abrogated state immunity.

The Copyright Act, 17 U.S.C. §§ 101 *et seq.*, encourages the production of artistic or literary works by granting authors and publishers valuable and enforceable rights, such as the exclusive rights to reproduce and distribute copyrighted works. § 106. As part of the broad scheme of copyright protection embodied in the Act, § 501(a) provides that "*Anyone* who violates any of the exclusive rights of the copyright owner . . . is an infringer of the copyright" (emphasis added). All infringers of copyright,[10] with only limited exceptions in narrow circumstances, are subject to actions for damages and injunctions (§§ 502, 504).

Unlike statutes considered in cases where the issue has been not whether Congress intended to create a remedy at all but only in what courts the remedy could be obtained, the Copyright Act contains both inclusive language in § 501(a) and

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[8] Where, as here, there is no real alternative remedy or forum, the Court should not be reluctant to find Congressional intent to abrogate, and the stringent requirements of *Atascadero State Hospital v. Scanlon, supra,* and *Welch v. State Dept of Highways, supra,* should not apply. But this Court need not reach that conclusion since, as will be shown, those stringent requirements are met here.

[9] *Richard Anderson Photography,* 852 F.2d at 126-129.

[10] The district court recognized that "the Copyright Act's general authorization for suit against 'anyone' is sufficiently broad to include the States." *Richard Anderson Photography v. Radford University,* 633 F.Supp. at 1159. See also *Johnson v. University of Virginia,* 606 F.Supp. 321, 324 (D. Va. 1985) (reasoning that "the language of the 1976 Act is at least as sweeping, and probably more sweeping, than the language of the 1909 Act in identifying the class of defendants subject to copyright infringement suits" and concluding that "the 1976 Act waived the states' Eleventh Amendment immunity from liability for damages and equitable relief for copyright infringments").

several other provisions that specifically show Congress' intent to bring the states within its reach, and to render them liable as infringers in the same manner as all other defendants, except where specific exemptions were carefully carved out. See generally *Richard Anderson Photography,* 852 F.2d at 126-129 (dissent).[11] There should be no doubt that the phrase "governmental bodies" used repeatedly in the statute, both as used colloquially and, more importantly here, as used throughout the copyright revision program that culminated in the Copyright Act of 1976, includes state entities. *See* House Comm. on the Judiciary, *Copyright Law Revision,* "Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law," 87th Cong., 1st Sess. at 129 (Comm. Print July 1961) (hereinafter "1961 Register's Report"), expressly noting that the law contained "nothing to prevent *governmental bodies,* at least of the States, from securing copyright...." (emphasis added).

Beyond these statutory provisions, Congress' intent to allow states to be sued in federal court for violating the Copyright Act is shown by the express statutory scheme of the Act itself. First, in § 106, Congress granted to copyright owners *exclusive* rights, subject only to carefully crafted exemptions.[12]

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[11] The Court used similar reasoning in holding, in *Patsy v. Board of Regents,* 457 U.S. 496 (1982), that exhaustion of state administrative remedies is not a prerequisite to an action in federal court under 42 U.S.C. § 1983. The Court examined a statute enacted after § 1983 that created a "specific, limited exhaustion requirement for adult prisoners bringing actions pursuant to § 1983," *Id.* at 508, and concluded that the exhaustion provisions of the more recent statute "make sense, and are not superfluous," only if Congress intended that § 1983 contain no general requirement of administrative exhaustion. *Id.* at 512. Similarly, the exemptions in the Copyright Act for state activity "make sense, and are not superfluous," only if Congress intended to abrogate state immunity and subject states to suit for copyright infringement.

[12] *See Goldstein v. California,* 412 U.S. 546, 560 (1973) (discussing, in a case considering a state's anti-piracy statute, the inherently broad reach of federal copyright protection): "When Congress grants an exclusive right or monopoly, its effects are pervasive; *no citizen or State may escape its reach"* (emphasis added).

Second, in § 301, Congress expressly preempted all state copyright laws—and even state laws equivalent to copyright. Third, 28 U.S.C. § 1338(a) grants to the federal courts exclusive jurisdiction of all actions arising under the federal copyright laws.

Finally, the Copyright Act permits the states themselves to obtain copyright protection. Congress was well aware that states and state entities regularly obtained federal copyright protection for their works.[13] It cannot be assumed that Congress intended to permit the states regularly to take advantage of the full benefits of the Copyright Act and at the same time be free of its obligations.

Under this statutory scheme, all copyright claims must be brought in federal court, applying the federal copyright laws. A decision denying a federal forum to claimants who allege copyright violations by states is essentially a conclusion that Congress intended to leave these claimants without a meaningful remedy, and to permit states to disregard the rights of copyright owners with impunity.

In this critical aspect the Copyright Act is altogether different from the statutes the Supreme Court has determined did not abrogate state immunity. In *Welch v. State Dep't of Highways, supra,* 107 S.Ct. at 2953 n. 19, for example, the Court recognized that the plaintiff there "is not without a remedy: she may file a worker's compensation claim against the State under

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[13] *See* 1961 Register's Report, *supra,* at 129 ("Almost every State in the Union has registered copyright claims in some of its informational publications"). *See also* Senate Comm. on the Judiciary, *Copyright Law Revision Study No. 33,* "Copyright in Government Publications," 86th Cong., 2d Sess. at 129 (Comm. Print 1961) "Most of the States have enacted statutes for the securing of copyright in certain of their publications or in their publications generally. And even in the absence of any statute, almost every State has claimed copyright in some of its publications. A survey by the Copyright Office shows that during the 5-year period 1950 through 1954 about 4,700 copyright claims were registered in the name of a State or a State agency or in the name of an official on behalf of a State." See generally 1 M. Nimmer, *Nimmer on Copyright* § 5.06[A] n.1 (1986).

[state law]." Similarly, in *Atascadero State Hospital v. Scanlon, supra,* 473 U.S. at 238 n. 2, the Court explained that immunity from federal suit under the statute involved there would not exempt the states from compliance with the law, because they would still be subject to suit in state court. The Court emphasized, "It denigrates the judges who serve on the stae courts to suggest that they will not enforce the supreme law of the land." *Id.*

There is not a shred of evidence to suggest that Congress intended to leave states free to violate federal law by infringing the rights of copyright owners. To the contrary, the entire statutory scheme unmistakably expresses Congress' intent to abrogate state immunity. To uphold the court of appeals' decision would frustrate that express Congressional intent.

CONCLUSION

For the foregoing reasons, the petition for *certiorari* should be granted.

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No. 88-651

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Supreme Court of the United States

OCTOBER TERM, 1988

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Petitioner,

v.

RADFORD UNIVERSITY, *et al.*,
Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

MOTION FOR LEAVE TO FILE BRIEF *AMICUS CURIAE* ON BEHALF OF THE AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION IN SUPPORT OF PETITIONER TOGETHER WITH BRIEF *AMICUS CURIAE*

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For The Fourth Circuit

MOTION FOR LEAVE TO FILE BRIEF *AMICUS CURIAE* ON BEHALF OF THE AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION IN SUPPORT OF PETITIONER

The American Intellectual Property Law Association (AIPLA) hereby respectfully moves this Court for leave to file a brief in this case as *amicus curiae* in support of Petitioner. The consent of the attorneys for Petitioner has been obtained for the filing of a brief *amicus curiae* by the AIPLA. The consent of the attorneys for the Respondents was requested by the AIPLA but was refused.

The AIPLA constitutes a national bar association of more than 5,600 members, including attorneys

whose interest and practice lies in the areas of patent, copyright, trademark, trade secret, and other intellectual property law. Because of the unique expertise of its members and its nonpartisan status, the AIPLA believes that its views on the issues raised by this case, and the implications of those issues, would be of aid to this Court.

Certain issues of national public importance which are raised by this case deeply concern the AIPLA. The decision below jeopardizes the rights of copyright owners generally and also the rights of owners of other forms of intellectual property. The decision below seems likely to allow the states free rein to pirate the copyrights and patents they use, as the owners of such intellectual property would be left without a forum in which redress for such piracy could be had. Thus, this case presents a question which has implications far beyond the particular facts now before this Court.

Because the AIPLA believes the case below wrongly decided and because the case involves an important question which affects owners of intellectual property generally, the AIPLA wishes to join Petitioner in urging this Court to grant a writ of certiorari and review this case on the merits. Consequently, the AIPLA respectfully requests that this Court grant the AIPLA leave to file its brief *amicus curiae* in the form submitted with this motion.

Respectfully submitted,

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BRIEF OF THE AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION AS *AMICUS CURIAE* IN SUPPORT OF PETITIONER

This *amicus curiae* brief is submitted in support of the petition for a writ of certiorari. Petitioner has consented to the filing of this brief, and respondent has refused such consent. A motion for leave to file this brief has been filed.

INTEREST OF THE *AMICUS*

The American Intellectual Property Law Association (AIPLA) is a national bar association of more than 5,600 members. Its members are attorneys whose

interest and practice lie in the areas of patent, copyright, trademark, trade secret, and other intellectual property law.[1] AIPLA's members include attorneys in private practice and those employed by corporations, universities, and government. Unlike many other areas of practice, in which separate and distinct plaintiffs' and defendants' bars exist, most, if not all, intellectual property law attorneys represent both plaintiffs and defendants.

AIPLA is deeply concerned about certain issues of public importance in this case. Specifically, if allowed to stand, the decision below would jeopardize the rights of copyright owners generally and also the rights of owners of other forms of intellectual property, including numerous patents of enormous value that are widely used by state governmental bodies. Simply put, if the decision below stands, states could pirate the copyrights and patents they use—from textbooks to road-paving machines—with impunity.

Because we believe the case below was wrongly decided, because it involves an important question of federal law which has not been, but should be, settled by this Court, and because the interests of intellectual property owners represented by our members would be directly and adversely affected if the decision below is allowed to stand, we join petitioner in urging this Court to grant a writ of certiorari and review this case on the merits.

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[1] Prior to 1984, AIPLA was known as the American Patent Law Association.

ARGUMENT

THE EXCLUSIVE JURISDICTION OF THE FEDERAL COURTS OVER COPYRIGHT AND PATENT MATTERS PRECLUDES APPLICATION OF STATE SOVEREIGN IMMUNITY UNDER THE ELEVENTH AMENDMENT

This case presents an important issue not presented in any Eleventh Amendment case previously decided by this Court: Does sovereign immunity under the Eleventh Amendment immunize a state which violates a federal right when: a) there is *exclusive* federal jurisdiction over that right; and b) such immunity would mean that *no* meaningful redress would be available to an aggrieved party for violations of that right in *any* court, state or federal?

The Constitution grants only to Congress, and not to the states, the power to enact uniform copyright and patent statutes. U.S. Const., Art. I, Sec. 8, Cl. 8. Those statutes, and the supremacy doctrine, have made copyright and patent rights exclusively federal in nature. 17 U.S.C. §301(a) (pre-empting state statutory or common law copyright); *Sears, Roebuck & Co. v. Stiffel & Co.*, 376 U.S. 225 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964).

Congress, in turn, has granted the federal courts exclusive jurisdiction over copyright and patent cases arising under those statutes. 28 U.S.C. §1338(a).[2]

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[2] That statute provides:

> The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, plant variety protection, copyrights, and trademarks. Such jurisdiction shall be exclusive of the courts of the states in patent, plant variety protection and copyright cases.

This Court's prior considerations of Eleventh Amendment immunity involved cases in which an aggrieved party, if deprived of the opportunity for redress in the federal courts, could nevertheless find such redress in state court.[3] Indeed, one of the basic rationales supporting Eleventh Amendment immunity has been that, the state courts being available, the plaintiff, although deprived of access to the federal courts, will not be completely without a forum. *Ex Parte Young*, 209 U.S. 123, 176 (1907) (Harlan, J., dissenting); *Employees v. Missouri Public Health Dept.*, 411 U.S. 279, 287 (majority opinion) and 298 (Marshall, J., concurring in result) (1973); *Atascadero State Hospital v. Scanlon*, 473 U.S. 234, 239-240, n.2 (1985).

But application of Eleventh Amendment immunity, combined with exclusive federal jurisdiction, would deprive copyright and patent owners of any forum to assert their rights. As a result, the Constitutionally-based rights of copyright and patent protection would exist only in theory: there would be no remedy for acts of infringement by the states, and the specific, exclusive federal jurisdiction of 28 U.S.C. §1338(a)

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[3] The only case we find in which exclusive federal jurisdiction has been urged as a factor to deny Eleventh Amendment immunity is pending before this Court: *Commonwealth of Pennsylvania v. Union Gas Co.*, No. 87-1241 (argued October 31, 1988). But even there, as was made clear at oral argument, the state's immunity was, in a sense, only partial: the state remained liable to the United States notwithstanding its immunity to suit by private parties. Here, and in all copyright and patent cases instituted by a private party, the immunity, if applicable, would be total, for only the private party—the copyright or patent owner and not the Government—is authorized by statute to bring suit. 17 U.S.C. §501(b); 35 U.S.C. §281.

would be meaningless in such cases. Copyright and patent owners could not be made whole by damage awards for state piracy of their property, and, without that remedy, states would not be motivated to comply with the law and obtain licenses for their uses of that property.

The Constitution itself states that the purpose behind the federal copyright and patent laws is to "promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." U.S. Const., Art. I., Sec. 8, Cl. 8. The decision below, under the guise of the Eleventh Amendment, allows the states to violate these federally-protected rights—it gives them a free, compulsory license, not intended by Congress or the Constitution. It thus conflicts with the Constitutional mandate of securing *exclusive*, and exclusively *federal*, rights to authors and inventors.

We respectfully urge this Court to review the decision below, for the reasons set forth herein and those advanced by petitioner, and to consider the important and previously unconsidered question whether sovereign immunity applies when the right at issue is violated by a state but is exclusively within federal jurisdiction.

CONCLUSION

This Court should grant petitioner's request for a writ of certiorari to review the Fourth Circuit's decision.

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ON PETITION FOR A WRIT OF CERTIORARI
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FOR THE FOURTH CIRCUIT

PETITIONER'S REPLY BRIEF

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PETITIONER'S REPLY BRIEF

There is no dispute between Petitioner and Respondents that Rule 17.1(c) of the Rules of this Court favors the grant of certiorari where "a federal court of appeals has decided an important question of federal law which has not been, but should be, settled by this Court . . . ." Nor can the Respondents deny that, as the Ninth Circuit held in *BV Engineering* v. *University of California, Los Angeles*, 858 F.2d 1394, 1400 (9th Cir. 1988), this Court "has never addressed the question of eleventh amendment immunity in a context where exclusive jurisdiction rests in the federal courts." Rather, it must be conceded that in every previous Eleventh Amendment case decided by this Court, the issue was " 'not the general immunity of the States from private suit . . . but merely the susceptibility of the States to suit before *federal tribu-*

nals.' " *Atascadero State Hospital* v. *Scanlon*, 473 U.S. 234, 240 n.2 (1985) (emphasis and ellipsis in original, quoting *Employees* v. *Missouri Dep't of Public Health and Welfare*, 411 U.S. 279, 293–94 (1973) (Marshall, J., concurring in result)). Finally, the importance of the question here presented to the entire copyright community is evidenced by the number of *amicus curiae* briefs filed on this issue in the Fourth, Ninth and First Circuits — and by its obvious impact on the governments of all fifty states.

That said, only the following need be added in reply to the Brief in Opposition (hereinafter "Br. in Opp.") filed by Respondents at the request of this Court:

I. Respondents' Brief Ignores the Major Thrust of the Petition for Certiorari

In stressing that the Fourth Circuit "studiously resorted to" and "follow[ed] so precisely the clear guidance of" this Court's decisions in *Atascadero*, *supra*, and *Welch* v. *State Department of Highways and Public Transportation*, 107 S. Ct. 2941 (1987), Respondents simply miss the major thrust of Petitioner's argument. Br. in Opp. at 4. Because the federal courts have exclusive jurisdiction over copyright suits (28 U.S.C. § 1338 (a)) and Congress has expressly preempted all state laws that "are equivalent to any of the exclusive rights within the general scope of copyright" (17 U.S.C. § 301(a)), the effect of recognizing Eleventh Amendment immunity here is to foreclose entirely a damage remedy created by Congress. Thus, in copyright cases, unlike other Eleventh Amendment cases, there is a compelling argument for not "studiously resorting to" and following "so precisely" the stringent Eleventh Amendment abrogation test set forth in *Atascadero* and *Welch* (*see* Petition for Certiorari at 6–11, 21–24). Since this Court has never yet applied that stringent test to foreclose a remedy in any forum, it is appropriate for the Court to consider whether the purpose underlying the Eleventh Amendment requires its application with full force when that would be the result.

Although Respondents argue that the interest advanced by the Eleventh Amendment "is the preservation of comity between state

and federal *governments*" (Br. in Opp. at 4, emphasis added), in fact, what the Eleventh Amendment protects is the proper balance of power between federal and state *courts*. *See Atascadero, supra*, 473 U.S. at 242; *Employees* v. *Missouri Public Health Dep't*, 411 U.S. at 285. It was because the federal courts must themselves decide in Eleventh Amendment cases "whether their own jurisdiction has been expanded" (*Atascadero, supra*, 473 U.S. at 243) that this Court imposed such a stringent test for determining, in most such cases, whether Congress has abrogated the Eleventh Amendment protection. However, in copyright cases, as the Ninth Circuit recognized in *BV Engineering, supra*, a finding of congressional abrogation "could not expand the jurisdiction of the federal courts" into the state courts' domain, because the federal courts already have exclusive jurisdiction and all equivalent state law has been preempted. There is simply no legitimate state court domain upon which to trample. Thus, the threat of federal encroachment upon state judicial authority, which is the major rationale for *Atascadero*'s stringent standard, is totally lacking in copyright cases.

For these reasons, the Fourth Circuit need not have followed so "precisely" the dictates of *Atascadero* in order to find, as did the Register of Copyrights in his recent Report (Register of Copyrights, *Copyright Liability of States and the Eleventh Amendment* 103 (June 1988) [hereinafter *Copyright Office Report*]), that Congress did intend to abrogate state immunity when it enacted the Copyright Act of 1976. *See* Note, *The Applicability of Eleventh Amendment Immunity Under the Copyright Acts of 1909 and 1976*, 36 Am. U.L. Rev. 163, 187–88 (1986). Indeed, it could have adopted the more flexible approach employed by the Seventh Circuit in *Gomez* v. *Illinois State Board of Education*, 811 F.2d 1030 (7th Cir. 1987), and *In re McVey Trucking, Inc.*, 812 F.2d 311 (7th Cir.), *cert. denied*, 108 S. Ct. 227 (1987).

As the Petition for Certiorari notes (at 18), the Seventh Circuit in *Gomez* held that abrogation by Congress may be found "not in so many words, but rather by [the statute's] effect," as, for example, "where any other reading of the statute in question would render nugatory the express terms of the provision." 811 F.2d at 1036. And in *McVey, supra*, the Seventh Circuit was willing to consider both the

words of the statute and the legislative history, "taken together," to determine if it could be "certain" that Congress intended to create a cause of action against the states. 812 F.2d at 326. Although the Petition for Certiorari in this case does not rely upon any direct conflict among the circuits, both of these Seventh Circuit cases do adopt a markedly different interpretation of this Court's *Atascadero* standard than the one adopted by the Fourth Circuit in the instant case.

II. The Separate Waiver Doctrine Is Not Dead

A different alternative approach to the stringent *Atascadero* abrogation test, at least in cases where the effect of Eleventh Amendment immunity would be to deny relief entirely, is the separate doctrine of waiver. As noted in the Petition for Certiorari (at 19–20), the Fourth Circuit erroneously viewed the waiver doctrine as, in effect, co–extensive with the *Atascadero* abrogation test, and therefore did not separately consider it.

Contrary to Respondents' assertion (Br. in Opp. at 4), the constructive waiver doctrine is not "a dead legal theory." This Court implicitly recognized as much when, in *Welch*, *supra*, it overruled its previous decision in *Parden* v. *Terminal Railway*, 377 U.S. 184 (1964), *only* to the extent that *Parden* was "inconsistent with the requirement that an *abrogation* of Eleventh Amendment immunity by Congress must be expressed in unmistakably clear language." 107 S. Ct. at 2948 (emphasis added).

Nor did the Fourth Circuit's opinion ever insinuate that the constructive waiver doctrine had been exterminated by this Court in *Welch*. Rather, as noted above, it believed that both doctrines required an identical analysis of congressional intent based solely upon the face of the statute. Indeed, if the Fourth Circuit's decision could possibly be read to support Respondents' suggestion that the waiver doctrine is "a dead legal theory," then it would definitely be in direct conflict with the decision of the First Circuit in *WJM, Inc.* v. *Massachusetts Department of Public Welfare*, 840 F.2d 996, 1001–05 (1st Cir. 1988), decided eight months after this Court allegedly killed off the waiver doctrine in *Welch*.

In *WJM*, the First Circuit expressly passed over the *Atascadero* abrogation test, and denied the Eleventh Amendment defense on the ground that Massachusetts had waived its Eleventh Amendment immunity by the affirmative act of filing bankruptcy proofs of claim. Critical to the First Circuit's analysis was the finding that states had been put "on notice" that such an affirmative act would subject them to the jurisdiction of the federal courts. *WJM*, 840 F.2d at 1003. Likewise, Petitioner here argues that the states have long been "on notice" that their affirmative acts in utilizing the copyrighted materials of others without paying royalties will subject them to damage suits in federal court. Respondents' contention that the waiver doctrine is "dead" merely serves to point up an issue presented by this case which ought to be resolved by this Court.

III. Respondents' Suggestion of the Availability of State Law Remedies Contradicts Congress' Express Preemption of Copyright Remedies, Thus Raising a Constitutional Issue Which This Court Should Resolve

Respondents recognize that at the heart of Petitioner's case is the unavailability of any viable damage remedy for state copyright infringement if the Eleventh Amendment bar is upheld. They therefore suggest that copyright proprietors may resort to not one, but *three* alternative remedies under Virginia law, "outside the context of the Copyright Act" (Br. in Opp. at 5–6). Thus, Respondents argue, either under article I, section 11 (the "due process" clause) of the Virginia Constitution, or under §§ 2.1–223.1 and 8.01–192 of the Virginia Code (authorizing the pursuit of "pecuniary claim[s] against the Commonwealth upon any legal ground"), or under the Virginia Tort Claims Act (Virginia Code §§ 8.01–195.1 to –195.8), the state courts of Virginia may award damages to copyright proprietors for the Commonwealth's infringement of their copyrights. Indeed, Respondents go so far as to urge that "every state in the Union provides, by constitution or statute, a remedy for unlawful taking of private property by the govern-

ment," which, it is suggested, would be available to redress state copyright infringement. (Br. in Opp. at 6 n.4).[1]/

The invocation of state law remedies utterly ignores the fact that, in section 301(a) of the Copyright Act of 1976, Congress has *expressly preempted* "all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright," and has expressly provided that, after January 1, 1978, "no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State."[2]/ It was expressly the intent of Congress in enacting that section to preempt all state law rights and remedies which are not "different in kind" from those protected under the Copyright Act. *Harper & Row, Publishers* v. *Nation Enterprises*, 501 F. Supp. 848 (S.D.N.Y. 1980), *aff'd*, 723 F.2d 195, 200–201 (2d Cir. 1983), *rev'd on other grounds*, 471 U.S. 539 (1985) (barring pursuit of state law conversion and tortious interference claims which were not "different in kind" from copyright infringement claim). Thus, enactment of § 301(a) abolished every state law claim based on "an act which, in and of itself, would infringe one of the exclusive rights" protected by the Copyright Act (*Id.*, 723 F.2d at 200).

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[1]/ Respondents also suggest (Br. in Opp. at 5) that an adequate remedy exists because, as the Fourth Circuit expressly held, Petitioner may still maintain a damage claim against a state employee, Deborah Brown, acting in her individual capacity. But Respondents cannot seriously contend that a damage award enforceable only against the personal assets of state civil servants could possibly constitute the equivalent of a damage claim against the state itself. Moreover, were the individual state agent able to claim or obtain indemnification from the state treasury, then the suit would be considered the equivalent of a suit against the state and barred by the Eleventh Amendment if the suit against the state were barred. *See, e.g., Edelman* v. *Jordan*, 415 U.S. 651, 664–65 (1974); *Dugan* v. *Rank*, 372 U.S. 609, 620 (1963); *Ford Motor Co.* v. *Dep't of Treasury of Indiana*, 323 U.S. 459, 464 (1945).

[2]/ House Report No. 94–1476 explains that "the intention of section 301 is to preempt and abolish any rights under the common law or statutes of a State that are equivalent to copyright and that extend to works coming within the scope of the Federal copyright law." H.R. Rep. No. 1476, 94th Cong., 2d Sess., at 130 (1976). That scope is extremely broad, covering works "fixed in any tangible medium of expression." That includes the copyrighted photographs owned by Petitioner. *See* 17 U.S.C. § 102.

Given the express action of Congress to occupy the entire copyright sphere and to preempt all "equivalent" rights of action under state law, the assertion of equivalent remedies under Virginia law would violate the Supremacy Clause of the Constitution under this Court's preemption decisions. *See, e.g., Sears, Roebuck & Co.* v. *Stiffel & Co.*, 376 U.S. 225, 230-233 (1964); *Goldstein* v. *California*, 412 U.S. 546 (1973); *see generally* Abrams, *Copyright, Misappropriation, and Preemption: Constitutional and Statutory Limits of State Law Protection*, 1983 Sup. Ct. Rev. 509 (1983). Far from providing a reason for this Court to *deny* a writ of certiorari in this case, if Respondents' argument that state law remedies are available has any merit at all, then its apparent conflict with the preemption doctrine raises a separate constitutional issue for review by this Court under the criteria enunciated in Rule 17.1. 3/

3/ Finally, Respondents suggest that the prospective injury to all copyright owners, if they are left without a damage remedy against infringing states, is simply a "hypothetical tale of woe," unsupported by any "actual needs" (Br. in Opp. at 7). But those "actual needs" are well documented in the Report of the Register of Copyrights, cited both in the Petition for Certiorari (at 7-8) and Respondents' brief (at 7 n.6), which documented several actual instances of harm to copyright proprietors (*Copyright Office Report* at 5-17), in support of its overall conclusion that "copyright proprietors have demonstrated they will suffer immediate harm if they are unable to sue infringing states in federal court." *Id.* at 103.

CONCLUSION

For the foregoing reasons, and those set forth in the Petition for Certiorari, petitioner respectfully prays that this Court grant a writ of certiorari to review the decision of the United State Court of Appeals for the Fourth Circuit.

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Respectfully submitted,

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